

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

JAY SCHUYLEMAN,

Plaintiff,

v.

BARNHART CRANE AND
RIGGING CO., et al.,

Defendants.

CASE NO. C23-0562JLR

ORDER

I. INTRODUCTION

Before the court are the parties' dueling *Daubert* motions to exclude evidence and testimony. Defendants Barnhart Crane and Rigging Co. and Barnhart Crane and Rigging LLC (collectively, "Barnhart") move the court to (i) exclude the testimony and report of Richard W. Klopp, Ph.D. (Klopp Mot. (Dkt. # 92); Klopp Reply (Dkt. # 106)); (ii) strike portions of Dr. Klopp's report (Klopp MTS (Dkt. # 86); Klopp MTS Reply (Dkt. # 89)); and (iii) exclude the testimony of Lance Morman (Morman Mot. (Dkt. # 91); Morman

Reply (Dkt. # 105)). Plaintiff Jay Schuyleman asks the court to exclude the testimony of Gregg S. Perkin (Perkin Mot. (Dkt. # 93); Perkin Reply (Dkt. # 108)). All of the motions are opposed. (Klopp Resp. (Dkt. # 101); Klopp MTS Resp. (Dkt. # 97); Morman Resp. (Dkt. # 103); Perkin Resp. (Dkt. # 100).) The court has considered the parties' *Daubert* motions, the relevant portions of the record, and the applicable law. Being fully advised,¹ the court DENIES Barnhart's motion to exclude Dr. Klopp's report and testimony, GRANTS in part and DENIES in part Barnhart's motion to strike Dr. Klopp's report, GRANTS Barnhart's motion to exclude Mr. Morman's report, and GRANTS in part and DENIES in part Mr. Schuyleman's motion to exclude Mr. Perkin's testimony.

II. BACKGROUND

Before examining the parties' respective motions, the court briefly details the factual and procedural background of this case.

A. Factual Background

This is a patent infringement case. Mr. Schuyleman alleges that Barnhart infringes the claims of United States Patent No. 8,317,244 (the "'244 Patent"). (*See* Third Am. Compl. (Dkt. # 42), Ex. 1.)² The '244 Patent, entitled "Apparatus and Method for Positioning an Object in a Building," is directed to "an improvement for an offset

¹ The parties do not request oral argument, and the court concludes that oral argument is not necessary to dispose of the motions, *see* Local Rules W.D. Wash. LCR 7(b)(4).

² At the outset of this case, Mr. Schuyleman asserted claims 1, 2, 4, 12, 13, 16, and 17 against Barnhart. (*See* MTS, Ex. 4 ("Infringement Contentions").) However, in conjunction with service of Dr. Klopp's report, Mr. Schuyleman informed Barnhart that claims 1, 4, 16, and 17 are "the claims [he] is pursuing at this time." (*See* 10/19/24 Email (Dkt. # 94-4) at 2; *see* Klopp Report at 12-15 (noting that only claims 1, 4, 16, and 17 are asserted).)

1 hoisting apparatus for use with a crane to lift a load.” (*Id.* at col. 2:13-14.) The ’244
2 Patent purports to facilitate the safe depositing of a load, such as a wall panel or crate,
3 into an opening in a building during construction. (*See generally id.*) Hanging a load
4 from a crane hook in front of an opening in a building is dangerous because workers must
5 approach a ledge and reach out to pull the load inside the building. (*See id.* at col.
6 1:35 44.) The ’244 Patent purports to resolve this problem through use of an “offset
7 hoisting apparatus” with a beam—or “rigid boom”—capable of being “selectively slid
8 between a refracted position and an extended position.” (*Id.* at col. 4:40-41.) The beam
9 travels along the x-axis by sliding through mounts attached to the offset hoisting
10 apparatus. (*Id.* at col. 3:43-53.) Once the beam slides into the appropriate position, the
11 load is secured to the hook at the end of the beam. (*See id.* at col. 4:40-43.) A crane can
12 then lift the offset hoisting apparatus and deposit the load several feet inside of an
13 opening, obviating the need for workers to pull the load into the building. (*See id.* fig. 1.)

14 Mr. Schuyleman alleges that Barnhart infringes the claims of the ’244 Patent “by
15 making, using, selling, offering to sell, and importing into the United States, certain
16 equipment with a moveable boom” including three of Barnhart’s products: (1) the
17 Moveable Counterweight Cantilever System (“MOCCS”) (e.g., Standard Movable
18 Counterweight Cantilever System and Movable Counterweight Double Beam); (2) the
19 Mini-MOCCS; and (3) the Mega-MOCCS (collectively, the “Accused Products”). (Third
20 Am. Compl. ¶ 6.)
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B. Procedural Background

Mr. Schuyleman timely served his Infringement Contentions. (*See* Infringement Contentions; 2/6/24 Order (Dkt. # 47) (setting 3/22/24 deadline for service of preliminary infringement contentions).) Barnhart timely served its invalidity and non-infringement contentions. (*See generally* Contention Amend. Motion (Dkt. # 76); 4/25/24 Order (Dkt. # 53) (setting 4/12/24 deadline for service of non-infringement and invalidity contentions).) On July 31, 2024, the parties filed a joint claim construction statement, and the parties completed their respective claim construction briefing in August 2024. (Joint Stmt. (Dkt. # 61); CC Briefing (Dkt. ## 62-65).) The court held a *Markman* claim construction hearing on October 4, 2024, and issued its claim construction order on October 9, 2024. (10/4/24 Min. Entry (Dkt. # 72); CC Order (Dkt. # 73).)

The parties exchanged opening expert reports on November 15, 2024, and rebuttal reports on December 13, 2024. (*See* 7/17/24 Order (Dkt. # 60) (setting expert disclosure deadline for 11/15/24).) The discovery deadline expired on January 3, 2025. (*See* 7/17/24 Order.) At the parties' request, the court extended the parties' deadline to take expert depositions to January 24, 2025. (11/5/2024 Order (Dkt. # 78).) The parties timely filed cross motions for summary judgment. (*See* Barnhart MSJ (Dkt. # 94); Schuyleman MSJ (Dkt. # 95); *see* 7/17/24 Order (setting dispositive motions deadline for 2/11/25).) The court has not yet ruled on the parties' motions for summary judgment.³

³ The parties' summary judgment motions will be addressed in a separate order.

1 This order addresses the parties' *Daubert* motions. The motions are fully briefed and ripe
2 for ruling.

3 III. ANALYSIS

4 The court first discusses the legal standards governing *Daubert* motions, and then
5 considers the parties' motions in turn.

6 A. Legal Standards Governing *Daubert* Motions

7 Federal Rule of Evidence 702 tasks the district court with "ensuring that an
8 expert's testimony both rests on a reliable foundation and is relevant to the task at hand."
9 *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 597 (1993); *see also Daubert v.*
10 *Merrell Dow Pharms., Inc. (Daubert II)*, 43 F.3d 1311, 1313 (9th Cir. 1995). An expert's
11 testimony is admissible under Rule 702 if: (1) the witness is sufficiently qualified as an
12 expert by knowledge, skill, experience, training, or education; (2) the scientific, technical,
13 or other specialized knowledge will help the trier of fact to understand the evidence or to
14 determine a fact in issue; (3) the testimony is based on sufficient facts or data; (4) the
15 testimony is the product of reliable principles and methods; and (5) the expert has reliably
16 applied the relevant principles and methods to the facts of the case. Fed. R. Evid.
17 702(a)-(d). The relevance inquiry considers whether "the knowledge underlying [the
18 expert testimony] has a valid connection to the pertinent inquiry" in the case. *Alaska*
19 *Rent-A-Car, Inc. v. Avis Budget Grp., Inc.*, 738 F.3d 960, 969 (9th Cir. 2013). Expert
20 testimony is relevant if it "assist[s] the trier of fact" in determining a fact at issue.
21 *Primiano v. Cook*, 598 F.3d 558, 564 (9th Cir. 2010).

1 In evaluating proffered expert testimony, the court acts as “a gatekeeper, not a fact
 2 finder.” *Id.* at 568. The role of the court is not to “decid[e] whether the expert is right or
 3 wrong, just whether [the] testimony has substance such that it would be helpful to a jury.”
 4 *City of Pomona v. SQM N. Am. Corp.*, 750 F.3d 1036, 1044 (9th Cir. 2014) (quoting
 5 *Alaska Rent-A-Car*, 738 F.3d at 969-70). Accordingly, “[c]hallenges that go to the
 6 weight of the evidence are within the province of” the jury—not the court. *Id.*; *see also*
 7 *Elosu v. Middlefork Ranch Inc.*, 26 F.4th 1017, 1024 (9th Cir. 2022) (noting that if the
 8 proposed expert testimony is both reliable and relevant, “its proponent is entitled to have
 9 the jury decide upon [its] credibility, rather than the judge” (citation omitted)). In
 10 evaluating the reliability of expert testimony, the court’s inquiry focuses “not on the
 11 correctness of the expert’s conclusions but on the soundness of his methodology.”
 12 *Daubert II*, 43 F.3d at 1318. The party offering the disputed expert testimony has the
 13 burden of establishing its admissibility. *Bldg. Indus. Ass’n of Wash. v. Wash. State Bldg.*
 14 *Code Council*, 683 F.3d 1144, 1154 (9th Cir. 2012). Because this is a patent case, the
 15 court applies “regional circuit law to procedural issues and Federal Circuit law to
 16 substantive and procedural issues pertaining to patent law.” *Whitserve, LLC v. Comput.*
 17 *Packages, Inc.*, 694 F.3d 10, 26 (Fed. Cir. 2012). The court assesses the parties’
 18 respective motions with these principles in mind.

19 **B. Barnhart’s Motion to Exclude Dr. Klopp’s Report and Testimony**

20 Mr. Schuyleman retained Dr. Klopp to opine on Barnhart’s alleged infringement
 21 of the ’244 Patent. (*See* Klopp Report (Dkt. # 92-2) at 1.) Barnhart argues that Dr.
 22 Klopp’s report and testimony should be excluded because (1) he is not a person of

1 ordinary skill in the art (“POSITA”); and (2) his opinions are based on unreliable
2 evidence. (*See* Klopp Mot. at 6, *id.* at 7-17.) The court addresses these arguments below.

3 1. Dr. Klopp Qualifies as a POSITA

4 Patent claims are analyzed from the perspective of one of ordinary skill in the art.
5 *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1361 (Fed. Cir. 2008).
6 Accordingly, to offer expert testimony on issues of patent infringement or validity, “a
7 witness must have at least ordinary skill in the art.” *Kyocera Senco Indus. Tools Inc. v.*
8 *Int’l Trade Comm’n*, 22 F.4th 1369, 1376 (Fed. Cir. 2022). “Without such skill, the
9 witness’ opinions . . . would not be based on any specialized knowledge, training, or
10 experience that would be helpful to the factfinder.” *Id.* During the claim construction
11 phase of this case, the court defined a POSITA as:

12 someone with a Bachelor’s degree in mechanical engineering, structural
13 engineering, applied physics, or a related field with at least four years of
14 engineering experience analyzing, designing, or developing construction
equipment for rigging or crane-related devices.

15 (10/2/24 Order (Dkt. # 71).) The parties dispute whether Dr. Klopp qualifies as a
16 POSITA. (*See* Klopp Mot. at 7, 11; Klopp Resp. at 2, 4.) Barnhart argues that Dr. Klopp
17 lacks the precise technical expertise required by the court’s POSITA definition—namely,
18 “at least four years of engineering experience analyzing, designing, or developing
19 construction equipment for rigging or crane-related devices.” (Klopp Mot. at 11; 10/2/24
20 Order.) Mr. Schuyleman counters that Dr. Klopp is qualified to testify because he has

1 experience “in the mechanical arts” and has the requisite background to satisfy the
 2 court’s POSITA standard.⁴ (*See* Klopp Resp. at 4.)

3 Dr. Klopp holds a Bachelor’s degree in mechanical engineering and a Ph.D. in
 4 engineering. (Klopp Mot., Ex. 2 at 15-20.) He has been employed as a Principal
 5 Engineer at Exponent, Inc. for 24 years. (*Id.*) His experience includes “engineering and
 6 application of stationary and mobile hoisting apparatuses used in construction,
 7 manufacturing, mining, machinery repair, and structural testing.” (*Id.*) For
 8 approximately two years, Dr. Klopp worked at least part-time assessing and
 9 recommending modifications to the cableways⁵ used to construct the Mike O’Callaghan-
 10 Pat Tillman Memorial Bridge (“Hoover Dam Bypass Project”). (Klopp Report, App’x A
 11 at 7 (“Klopp CV”); *see* 1st Dep. of R. Klopp (Dkt. # 92-4) (“Klopp 1st Dep.”) at 27:2-25;
 12 *see* 2d Dep. of R. Klopp (Dkt. # 92-5) (“Klopp 2d Dep.”) at 37:4-13, 39:4-13.) He also
 13 has experience evaluating the “hoisting gearing of a crane used as a clam shell dredge.”
 14 (Klopp 1st Dep. at 28:2-20.) As part of a large project to remove a tunneling machine
 15 from a mine, Dr. Klopp and his team performed a structural analysis related to the
 16 attachment point for one of the lifts used in the project. (*Id.* at 31:8-21, 33:5-34:1.) Dr.
 17 Klopp also played a role in assessing the structural integrity of a crane that was exposed
 18 to a fire—including “an analysis of the materials and designs” of the crane, although he

20 ⁴ In the alternative, Mr. Schuyleman argues that Dr. Klopp need not qualify as a POSITA
 21 to testify as an expert. (Klopp Resp. at 3.) Because the court concludes that Dr. Klopp is a
 POSITA, the court need not resolve that dispute here.

22 ⁵ Dr. Klopp stated that “cableways are a kind of crane.” (Klopp 2d Dep. at 50:23-24.)

1 did not complete a “full-on . . . structural review” of the crane in that project. (*Id.* at
2 34:2-22, 35:10-21; Klopp 2d Dep. at 45:14-18.) Beginning in 2012 and on and off for “a
3 couple of years” afterwards, Dr. Klopp also assessed the cause of failed machinery at an
4 iron ore concentrator facility. (Klopp 2d Dep. at 47:8-25.)

5 Barnhart asserts that the aforementioned experiences do not sufficiently qualify as
6 work “analyzing, designing, or developing” rigging or crane-related devices—let alone
7 *four years’* worth of experience. (Klopp Mot. at 7-11; Klopp Reply at 6-7.) Even
8 assuming that is true, Dr. Klopp provided several additional examples of his rigging and
9 crane-related work experience, including analyzing and testing a pivot structure of a
10 crawler crane, conducting failure analyses of a tower crane and the axle of an all-terrain
11 boom lift, and analyzing and testing the failure resistance of lift braking mechanisms, to
12 name a few. (*See, e.g.*, Klopp Decl. (Dkt. # 101-1) ¶¶ 17(a), (d), (i), (j).)⁶ In viewing
13 these experiences collectively with the experiences listed on Dr. Klopp’s curriculum
14 vitae, the court is confident that Dr. Klopp has at least four years’ worth of experience
15 analyzing, designing, or developing rigging or crane-related devices. Accordingly, the
16 court concludes that Dr. Klopp qualifies as a POSITA and may offer expert testimony
17 about infringement.

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20 ⁶ Barnhart contends that these latter examples should not be considered in determining
21 Dr. Klopp’s qualifications to testify as an expert because they were not timely disclosed pursuant
22 to Rule 26(a)(2). Barnhart accordingly moves to strike Dr. Klopp’s Declaration. (Klopp Reply
at 6.) Barnhart does not explain, however, why disclosure of Dr. Klopp’s additional
qualifications at this stage is harmful. (*See generally* Klopp Reply.) Accordingly, the court
denies Barnhart’s request to strike Dr. Klopp’s Declaration.

2. Dr. Klopp's Methodology is Reliable

Barnhart also asserts that Dr. Klopp's testimony should be excluded because portions of his report refer to images from Barnhart's marketing materials. (*See* Klopp Mot. at 13-17.) Barnhart challenges these images on two separate bases.

First, Barnhart challenges Dr. Klopp's use of images from Barnhart's marketing materials purportedly depicting the Mini-MOCCS and the Mega-MOCCS.⁷ (Klopp Mot. at 16; *see id.* n.1, n.2.) Mr. Schuyleman contends that Dr. Klopp's use of the images is appropriate because his opinions are derived from a variety of sources in addition to the images and videos. (*See* Klopp Resp. at 3-4.)

The court agrees with Mr. Schuyleman. Barnhart's argument for exclusion appears to depend on Barnhart's belief that Dr. Klopp's opinions rely entirely on the marketing materials. (*See* Klopp Reply at 7 ("[Dr.] Klopp's opinion that limitation 1[c] of claim 1 . . . is met by the Accused Products . . . relies exclusively on inaccurate cartoons and not the Accused Product.") (emphasis in original).) Although "advertisements alone are generally insufficient evidence of infringement[.]" *Pellegrini v. Analog Devices, Inc.*, No. Civ.A. 02-11562RWZ, 2006 WL 83472, at *3 (D. Mass. Jan. 11, 2006), *aff'd*, 312 F. App'x 304 (Fed. Cir. 2008), Dr. Klopp represents that his

⁷ Barnhart also takes issue with the fact that Dr. Klopp did not "produce a Barnhart representative to validate or explain" the advertising videos. (Klopp Mot. at 16; *see also* Klopp Reply at 7 (arguing that Barnhart failed to authenticate the advertising materials).) Federal Rule of Evidence 703, however, explicitly permits an expert to rely on evidence or data that the expert has not personally observed. *See* Fed. R. Evid. 703 ("An expert may base an opinion on facts or data in the case that the expert *has been made aware of or* personally observed.") (emphasis added). Although Dr. Klopp cannot testify regarding the truth of the matters asserted in the materials, he can refer to them in explaining his opinions.

1 | opinions are based on the specification sheets, operating procedures, and other materials
2 | related to the Mini-MOCCS and Mega-MOCCS, *in addition to* the marketing materials.
3 | (Klopp Report at 11; *id.* at App’x C (listing materials Dr. Klopp “considered and/or relied
4 | on when authoring this report and the [] Claims Charts” attached to his report at
5 | Appendix D).) To the extent that Barnhart argues that Dr. Klopp may not rely on
6 | materials from Barnhart’s website as a general matter, the court is not persuaded. *See*
7 | *Glaukos Corp. v. Invantis, Inc.*, No. SACV-18-620 JVS (JDEx), 2020 WL 10501851, at
8 | *11-*12 (C.D. Cal. July 23, 2020) (concluding that expert’s reliance on alleged
9 | infringer’s marketing materials did not warrant exclusion because expert “may testify as
10 | to his understanding of [alleged infringer’s] informational materials and how . . . he
11 | would understand the [infringing product] to work based on [those] materials”).

12 | Second, Barnhart challenges certain website images of the Mini-MOCCS and
13 | Mega-MOCCS that Dr. Klopp purportedly modified to illustrate that configurations of
14 | these products satisfy the claim limitations “front mount,” “front boom aperture,” “rear
15 | mount,” and “rear boom aperture.” (Klopp Mot. at 13-14.) Barnhart asserts that these
16 | images are not reliable because Dr. Klopp did not refer to materials showing any
17 | “*interior* components” of these products in his report. (*Id.*) Barnhart further asserts that
18 | these images do not accurately represent the interior components of these products. (*Id.*
19 | at 14-15 (citing Kaercher Decl. (Dkt. # 92-1) ¶ 14).) The court declines to exclude Dr.
20 | Klopp’s testimony on this basis. Dr. Klopp may testify about how the Accused Products
21 | work based on Barnhart’s materials. *Glaukos Corp.*, 2020 WL 10501851, at *11-*12.
22 | Furthermore, the court has not found any authority providing that an expert cannot

1 prepare illustrations or annotate a diagram to support his opinions. Indeed, several
 2 decisions have held to the contrary. *See Icon-IP Pty Ltd. v. Specialized Bicycle*
 3 *Components, Inc.*, 87 F. Supp. 3d 928, 950-51 (N.D. Cal. 2015) (expert’s testimony
 4 permitted where expert provided illustrations supporting his opinion that the accused
 5 products did not satisfy claim limitations); *Power Integrations, Inc. v. ON Semiconductor*
 6 *Corp.*, 396 F. Supp. 3d 851, 889 (N.D. Cal. 2016) (taking no issue with expert’s
 7 annotations of circuit schematics to support his opinion). The “correctness” of Dr.
 8 Klopp’s conclusions go to the weight of the evidence. *See Daubert II*, 43 F.3d at 1318;
 9 *see also Elosu*, 26 F.4th at 1024 (“[S]haky but admissible evidence is to be attacked by
 10 cross examination . . . not exclusion.”); *cf. Nat’l Prods., Inc. v. Arkon Resources, Inc.*,
 11 No. CV 18-02936 AG (SSx), 2019 WL 1034321, at *7-*8 (C.D. Cal. Jan. 9, 2019)
 12 (defendant’s challenges to plaintiff’s conclusions supported by expert’s annotated image
 13 were questions of fact).⁸

14 Accordingly, the court finds Dr. Klopp’s opinions sufficiently reliable and denies
 15 Barnhart’s motion to exclude his report and testimony.

18 ⁸ Barnhart also challenges Dr. Klopp’s opinions because he did not see the Accused
 19 Products in person and because his associate created the diagrams purporting to show the cross-
 20 sections. (Klopp MTS at 15.) These challenges, however, go to the weight of the evidence and
 21 are better suited for cross examination. *Cf. J.R. Simplot Co. v. McCain Foods USA, Inc.*, 713 F.
 22 Supp. 3d 904, 974 (D. Idaho 2024) (“The degree to which [expert] was involved in the
 preparation . . . may be relevant to how much weight [his] testimony should be given, but those
 factors alone do not warrant exclusion.”); *see also* Fed. R. Evid. 703 (permitting experts to
 render opinions on “facts or data in the case that the expert has been made aware of or personally
 observed”).

1 **C. Barnhart’s Motion to Strike Portions of Dr. Klopp’s Report**

2 Barnhart also seeks to strike the following portions of Dr. Klopp’s report: (i) his
3 discussion of the doctrine of equivalents theory; (ii) his reliance on technical images;
4 (iii) his theories relating to the “improvements” to the offset hoisting apparatus; and
5 (iv) his identification of new allegedly infringing structures on the Accused Products.
6 (Klopp MTS at 2.) Barnhart contends that these constitute new theories that were not
7 disclosed in Mr. Schuyleman’s Infringement Contentions. (*See id.*) The court first
8 discusses the relevant legal standard, and then addresses Barnhart’s arguments.

9 1. Legal Standard Governing Infringement Contentions

10 Infringement contentions “require parties to crystallize their theories of the case
11 early in the litigation and to adhere to those theories once they have been disclosed.”
12 *REC Software USA, Inc. v. Bamboo Sols. Corp.*, No. C11-0554JLR, 2012 WL 3527891,
13 at *2 (W.D. Wash. Aug. 15, 2012). Under this District’s Local Patent Rules, a patentee’s
14 infringement contentions must “identify[] specifically where each element of each
15 Asserted Claim is found within each Accused [Product].” Local Patent Rules W.D.
16 Wash. LPR 120(c). “The patentee’s infringement contentions [] must be specific enough
17 to provide reasonable notice to the defendant why the plaintiff believes it has a
18 reasonable chance of proving infringement.” *Uthervers Gaming LLC v. Epic Gaming,*
19 *Inc.*, No. C22-0799RSM-TLF, 2023 WL 4908304, at *5 (W.D. Wash. July 10, 2023)
20 (internal quotation and citations omitted). Infringement contentions, however, “do not
21 need to include direct proof or direct evidence of infringement.” *AntiCancer, Inc. v.*
22 *Pfizer, Inc.*, 769 F.3d 1323, 1338 (Fed. Cir. 2014).

Expert reports may not introduce new infringement theories that are not set forth in the party's contentions. *Apple Inc. v. Samsung Elec. Co., Ltd.*, No. 5:12-cv-0630-LHK-PSG, 2014 WL 12917334, at *1 (N.D. Cal. Jan. 9, 2014).⁹ "The scope of contentions and expert reports, are not, however, coextensive." *Id.* (internal quotation and citation omitted). In fact, "[i]n patent litigation, expert reports are expected to provide more information than is contained in infringement contentions." *Digital Reg. of Texas, LLC v. Adobe Sys. Inc.*, No. CV 12-01971-CW (KAW), 2014 WL 1653131, at *5 (N.D. Cal. Apr. 24, 2014). "The threshold question" is "whether the expert has permissibly specified the application of a disclosed theory or impermissibly substituted a new theory altogether." *Id.*

2. The Doctrine of Equivalents Theory

Barnhart argues that Dr. Klopp's report advances an "entirely new theory" of infringement under the doctrine of equivalents ("DOE") "relating to Claim[] [1] (limitation 1.c)" of the MOCCS.¹⁰ (Klopp MTS at 5-6; Klopp MTS Reply at 2; *see also* Klopp MTS at 6 (citing Klopp Report, App'x D at 33-34, 36, 39, 41 (advancing DOE arguments relating to the MOCCS product)).) Barnhart contends that Mr. Schuyleman's

⁹ As this court previously noted, the Northern District of California's local patent rules closely track that of the Western District of Washington. *See, e.g., REC Software*, 2012 WL 3527891, at *5. The court accordingly finds caselaw from the Northern District of California helpful in deciding these contentions issues.

¹⁰ In its motion to strike, Barnhart appears to seek to strike Dr. Klopp's DOE arguments relating to independent claim 1 and dependent claims 2, 12-13, and 16-17. (*See* Klopp MTS at 6.) Barnhart, however, abandoned its argument with respect to claims 2, 12-13, and 16-17 in its reply, and the court accordingly does not address those arguments here. *See McCarthy v. Amazon.com, Inc.*, No. C23-0263JLR, 2023 WL 5509258 n.5 (W.D. Wash. Aug. 25, 2013).

1 Infringement Contentions include only a “boilerplate reservation of rights” under the
2 DOE and therefore do not adequately disclose this new theory with respect to the
3 MOCCS. (*See* Klopp MTS at 5-6.) Barnhart requests that this new DOE theory be
4 stricken from Dr. Klopp’s report. (*See* Klopp MTS Reply at 2.) Mr. Schuyleman admits
5 that Dr. Klopp’s report alleges a new DOE theory of infringement with respect to the
6 MOCCS product, but seeks leave to amend its contentions because the new theory
7 “impacts only a single limitation” related to the MOCCS. (Klopp MTS Resp. at 9.)

8 The Local Patent Rules require a plaintiff’s infringement contentions to state
9 “[w]hether each element of each asserted claim is claimed to be literally present and/or
10 present under the doctrine of equivalents in the Accused Device[.]” Local Patent Rules
11 W.D. Wash. LPR 120(e). These requirements serve a notice function. *See Phigenix, Inc.*
12 *v. Genentech, Inc.*, 783 F. App’x 1014, 1018 (Fed. Cir. 2019) (considering the Northern
13 District of California’s local patent rules). Indeed, they “bolster discovery” under the
14 Federal Rules because they “allow the defendant to pin down the plaintiff’s theories of
15 liability . . . thus confining discovery and trial preparation to information that is pertinent
16 to the theories of the case.” *Id.* (citation omitted). Consequently, a boilerplate statement
17 regarding the DOE in infringement contentions is insufficient to preserve a DOE
18 argument. *OptimumPath, LLC v. Belkin Int’l, Inc.*, No. 09-CV-01398 CW, 2011 WL
19 1399257, at *8 (N.D. Cal. Apr. 12, 2011), *aff’d*, 466 F. App’x 904 (Fed. Cir.
20 2012) (noting that “judges of this court have rejected plaintiffs’ attempts to assert claims
21 under the doctrine of equivalents with blanket statements”). Mr. Schuyleman does not
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1 dispute that his contentions alleged only boilerplate DOE theories. (*See generally* Klopp
2 MTS Resp.)

3 A party seeking to amend its contentions must demonstrate good cause. *See REC*
4 *Software*, 2012 WL 3545056, at *6; *see also* Local Patent Rules W.D. Wash. LPR 124
5 (permitting amendments to infringement contentions “only by order of the Court upon a
6 timely showing of good cause”). The good cause inquiry considers first whether the
7 moving party was diligent in amending its contentions and then whether the non-moving
8 party would suffer prejudice if the motion to amend were granted. *AG Acquisition, LLC*
9 *v. Flying Crocodile, Inc.*, No. C19-1278BJR, 2021 WL 2778578, at *4 (W.D. Wash. July
10 2, 2021).

11 The party seeking to amend its contentions bears the burden of establishing
12 diligence. *O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1366-67
13 (Fed. Cir. 2006). Here, Mr. Schuyleman’s briefing is devoid of any analysis showing
14 diligence. (Klopp MTS Resp. at 9; *see generally id.* at 9-10.) And the court cannot
15 conclude from the record that Mr. Schuyleman diligently sought to amend his
16 Infringement Contentions. On October 16, 2024—one week after the court issued its
17 claim construction order—Barnhart notified Mr. Schuyleman’s counsel that Barnhart
18 intended to amend its contentions and asked whether Mr. Schuyleman would seek to
19 amend his Infringement Contentions. (*See* MTS, Ex. 7.) On October 17, 2024, Mr.
20 Schuyleman’s counsel represented that Mr. Schuyleman did not intend to amend his
21 Infringement Contentions. (*See id.*) On October 22, 2024, Barnhart sought leave to
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1 amend its non-infringement and invalidity contentions, which the court granted on
2 November 26, 2024. (Amend. Cont. Mot. (Dkt # 76); Amend. Cont. Order (Dkt. # 81).)

3 On November 15, 2024, Mr. Schuyleman served Dr. Klopp's report containing the
4 new DOE argument. (*See* MTS, Ex. 9 at 2-3 (11/15/24 email serving Dr. Klopp's
5 opening expert report).) On November 19, 2024—four days after receiving Dr. Klopp's
6 report—Barnhart's counsel notified Mr. Schuyleman's counsel that the “boilerplate
7 [DOE] reservations are inadequate under the Local Patent Rules to provide Barnhart
8 notice of the extent of Mr. Schuyleman's contentions” and requested that the DOE
9 theories be removed from Dr. Klopp's report. (MTS, Ex. 8 at 4.) On November 26,
10 2024, Mr. Schuyleman's counsel responded that Dr. Klopp's report did not assert new
11 theories and that Mr. Schuyleman “will not be voluntarily removing any aspect of Dr.
12 Klopp's report.” (*Id.*, Ex. 9.) By including the new DOE theory in Dr. Klopp's expert
13 report, Mr. Schuyleman, in effect, “attempted to amend [his] prior disclosures without
14 formally asking to do so.” *Corus Realty Holdings, Inc. v. Zillow Grp., Inc.*, No. C18-
15 0847JLR, 2020 WL 488545, at *8 (W.D. Wash. Jan. 30, 2020), *aff'd*, 860 F. App'x 728
16 (Fed. Cir. 2021). “This was not an effort in diligence but rather in subversion of the
17 Local Patent Rules.” *Id.*

18 Because Mr. Schuyleman has not demonstrated diligence, the court is not required
19 to consider whether his untimely disclosure prejudiced Barnhart. *See Corus Realty*
20 *Holdings*, 2020 WL 488545, at *8; *Hemopet v. Hill's Pet Nutrition, Inc.*, No. SACV
21 12-1908-JLS (JPRx), 2014 WL 12603093, at *3 (C.D. Cal. Sept. 3, 2014) (“The “good
22 cause” analysis ends with a determination that [plaintiff] was not diligent.”)

1 Nevertheless, the court concludes that Barnhart would be prejudiced by permitting
2 amendment. Mr. Schuyleman withheld the full scope of his DOE infringement theory for
3 a majority of the discovery period. Although the discovery period closed on January 3,
4 2025 (*see* 7/17/24 Order), Mr. Schuyleman's untimely disclosure deprived Barnhart of
5 any realistic ability to conduct discovery on the new DOE theory. Indeed, had Barnhart
6 wanted to serve written discovery on these theories, it would have needed to formulate
7 and serve those requests at least 30 days prior to the discovery cutoff. *See* Fed. R. Civ. P.
8 33(b)(2); Fed. R. Civ. P. 34(b)(2)(A). Barnhart therefore would have needed to serve
9 those requests on Mr. Schuyleman by December 4, 2024—nine days before its rebuttal
10 report was due. (*See* 7/17/24 Order.)

11 Mr. Schuyleman contends that Barnhart would not be prejudiced because it had an
12 opportunity to depose Mr. Schuyleman (as the corporate designee for Flying Forklift,
13 LLC) in December 2024, and Dr. Klopp in January 2025. (Klopp MTS Resp. at 9-10.)
14 These facts do not change the court's analysis. As explained above, Barnhart
15 communicated to Mr. Schuyleman by no later than November 19, 2024, its belief that his
16 Infringement Contentions failed to provide notice of his DOE theories. Mr. Schuyleman
17 was therefore "on notice of the deficiency" and failed to amend his contentions "at his
18 own risk." *See Finjan, Inc. v. Blue Coat Sys., Inc.*, No. 13-CV-03999-BLF, 2015 WL
19 3640694, at *5 (N.D. Cal. June 11, 2015). Accordingly, the court will not permit Mr.
20 Schuyleman to amend his Infringement Contentions to include his DOE theory at this
21 stage.
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1 3. Dr. Klopp's Use of Technical Images

2 Barnhart also faults Dr. Klopp's report for "accus[ing] actual products for the first
3 time." (Klopp MTS at 6 (capitalization omitted).) Specifically, Barnhart argues that Dr.
4 Klopp's report improperly "map[s] claim limitations onto an *actual* product" in technical
5 images of the Accused Products, whereas Mr. Schuyleman's Infringement Contentions
6 "accus[ed] only digital renderings of the Accused Products," even though Mr.
7 Schuyleman had access to the technical images before serving his Infringement
8 Contentions. (*Id.* at 6-7 (citing S. Douglass Decl. (Dkt. # 86-5) ¶¶ 7-8, 11-12) (emphasis
9 in original).) Barnhart asserts that Dr. Klopp's report should be stricken because, by
10 failing to amend his Infringement Contentions to include these technical images, Mr.
11 Schuyleman "deprived Barnhart of early notice of the *actual* features asserted to satisfy
12 the claim limitations[.]" (Klopp MTS at 9.) The court is not persuaded by Barnhart's
13 argument.

14 The Local Patent Rules require a plaintiff's infringement contentions to include a
15 chart "identifying specifically where each element of each Asserted Claim is found
16 within each Accused Device." *See* Local Patent Rules W.D. Wash. LPR 120(c). Expert
17 reports may "include information outside of the infringement contentions" so long as that
18 information does not "alter[] the disclosed theory of infringement." *See Dig. Reg. of*
19 *Texas*, 2014 WL 1653131, at *5. Indeed, "[i]t is illogical to force a plaintiff to only be
20 able to use evidence in its expert reports that was originally in its infringement
21 contentions." *Sol IP, LLC, v. AT&T Mobility LLC*, No. 18-cv-526, 2020 WL 10045985,
22 at *2 (E.D. Tex. Apr. 23, 2020). The court therefore cannot conclude that Dr. Klopp's

1 use of the technical images asserts new theories of infringement or that his report should
2 be stricken on this basis.

3 4. Dr. Klopp's Opinions Regarding the "Improvement" to the "Offset Hoisting
4 Apparatus"¹¹

5 Barnhart also argues that Dr. Klopp's report advances a new theory regarding the
6 "improvement" to the offset hoisting apparatus. (Klopp MTS at 9-11.) Barnhart
7 contends that Mr. Schuyleman's Infringement Contentions allege that each of the
8 Accused Products meet the limitations of the preamble of claim 1 by "compris[ing] an
9 offset hoisting apparatus having at least a top side, a bottom side, a front side, and a rear
10 side, for use with a crane apparatus to lift a load." (*Id.* at 10 (citing Infringement
11 Contentions, Ex. 1 at 1, Ex. 2 at 1, Ex. 3 at 1).) In contrast, Barnhart asserts, Dr. Klopp's
12 report advances the new theory that the "improvement" has the claimed top, bottom,
13 front, and rear sides, "*rather than the* 'offset hoisting apparatus'" and identifies for the
14 first time the "locations of the side of the improvement." (*Id.* at 9 (emphasis in original);
15 *id.* at 10 (cleaned up); *see* Reply at 3-4.)

16 Mr. Schuyleman responds that claim 1 is a "Jepson" claim¹² and therefore "the
17 claimed invention consists of the preamble in combination with the improvement."

18 ¹¹ Per the court's request, the parties submitted supplemental briefing on this issue. (*See*
19 Barnhart Supp. Br. (Dkt. # 118); Schuyleman Supp. Br. (Dkt. # 119).)

20 ¹² A "Jepson" claim contains three parts: "(1) a preamble comprising a general
21 description of all the elements or steps of the claimed combination which are conventional or
22 known, (2) a phrase such as 'wherein the improvement comprises,' and (3) those elements, steps
and/or relationships which constitute that portion of the claimed combination which the applicant
considers as the new or improved portion." 37 C.F.R. § 1.75(e); *see Rowe v. Dror*, 112 F.3d
473, 479 (Fed. Cir. 1997).

(Klopp MTS Resp. at 5 (citing *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315 (Fed. Cir. 1985)). Mr. Schuyleman therefore asserts that whether Dr. Klopp’s report opines that the Accused Products infringe the ’244 Patent via the “offset hoisting apparatus or the improvement combined with the offset hoisting apparatus does not introduce a ‘new theory’ of infringement.” (Klopp MTS Resp. at 5.) In his supplemental briefing, Mr. Schuyleman also appears to argue that he did not need to separately identify the “improvement” to the offset hoisting apparatus in his infringement contentions because “the preamble of claim 1 . . . does not require a specific variety of ‘offset hoisting apparatus.’” (Schuyleman Supp. Br. at 3; *see id.* (“whether the ‘offset hoisting apparatus’ of the preamble of claim 1 is the offset hoisting apparatus *by itself* or the offset hoisting apparatus *as the claimed combination* should have no impact on the infringement arguments in this case”)) (emphasis in original).¹³ Barnhart argues that under the Jepson format, the offset hoisting apparatus and the improvement are separate claim limitations that therefore needed to be separately identified in Mr. Schuyleman’s Infringement Contentions. (*See* Barnhart Supp. Br. at 3-4.)¹⁴

¹³ In his supplemental briefing, Mr. Schuyleman represents that the court “refus[ed] to construe the term “offset hoisting apparatus[.]” (Schuyleman Supp. Br. at 3.) The court clarifies for the record that it did not “refuse[.]” to construe “offset hoisting apparatus.” Rather, the court “decline[d] to rule on” the parties’ disputes regarding the alleged indefiniteness of the term “offset hoisting apparatus” during the *Markman* hearing, but stated that it would consider that dispute during the summary judgment stage should the parties choose to raise it. (CC Order at 5; *Markman Hr’g Tr.* (Dkt. # 75) at 5:5-6:1.) The parties have briefed this issue in their respective summary judgment motions and the court will address that dispute in a separate order.

¹⁴ The court also clarifies for the record that it held that “*claim 1* is written in Jepson format.” (5/6/25 Min. Order (Dkt. # 117) (emphasis added).) Barnhart represents that “[t]he parties agree that every claim in the ’244 Patent is a Jepson claim.” (Barnhart Supp. Br. at 4.)

1 During the claim construction phase of this case, the court held—and the parties
2 agreed—that the preamble of claim 1 is limiting. (*See* Markman Hr’g Tr. at 6:2-5,
3 6:13-19; *see also* CC Order at 5 (holding that the preamble of claim 1 is limiting).) The
4 preamble is considered to be limiting “if the claim preamble, when read in the context of
5 the entire claim, recites limitations of the claim, or, if the claim preamble is necessary to
6 give life, meaning, and vitality to the claim.” *In re Xencor, Inc.*, 130 F.4th 1350, 1357
7 (Fed. Cir. 2025) (citation and internal quotations omitted). Additionally, when the Jepson
8 format is used in a claim, the preamble of that claim functions as a “limitation because it
9 defines, in part, structural limitations of the claimed invention” described in the prior art.
10 *See Boston Sci. Corp. v. Micrus Corp.*, 556 F. Supp. 2d 1045, 1060 (N.D. Cal. 2008)
11 (citing *Epcon Gas Sys. Inc. v. Baur Compressors, Inc.*, 279 F.3d 1022, 1029 (Fed. Cir.
12 2002)). Consequently, for purposes of patent infringement, “[t]he preamble in a Jepson
13 claim constitutes a limitation” that must be met by the accused device. *See Dali*
14 *Wireless, Inc. v. Corning Optical Commc’ns LLC*, No. 20-CV-06469-EMC, 2021 WL
15 3037700, at *3 n.2 (N.D. Cal. July 19, 2021).¹⁵

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18 For purposes of this order, the court offers no opinion as to whether any claims other than claim
19 1 are Jepson claims.

20 ¹⁵ In the context of deciding whether a Jepson claim preamble had sufficient written
21 description, the Federal Circuit affirmed that the preamble of a Jepson claim recites a distinct
22 limitation: “A patentee cannot be permitted to use a Jepson claim to avoid the requirement that
[t]he be in possession of the claimed invention simply by asserting something is well-known in
the prior art. For example, a patentee cannot obtain a Jepson claim with a preamble that says that
a time machine is well-known in the art without describing a time machine[.]” *Xencor*, 130
F.4th at 1362.

1 Mr. Schuyleman agrees that the “offset hoisting apparatus” is the “prior art” and
2 that the improvement that he claims in the ’244 Patent is “different from an offset
3 hoisting apparatus.” (*See* Schuyleman MSJ Resp. (Dkt. # 102) at 12 (citing Klopp Reb.
4 Report (Dkt. # 94-9) at 38 (“Thus, the prior art is an offset hoisting apparatus.”); 11/8/24
5 Dep. of J. Schuyleman (Dkt. # 94-21) at 41:3-6 (not disputing that the “improvement [he]
6 claim[ed] in the patent is different from an offset hoisting apparatus”); *id.* at 40:6-20.)
7 The claim language attributes the top, bottom, front, and rear side claim elements to the
8 offset hoisting apparatus, rather than to the claimed improvement. (*See* ’244 Patent at
9 col. 6:1-5; *see id.* at col. 7:3-5 (“The improvement of claim 1 wherein the front mount is
10 fixed with the *front side of the offset hoisting apparatus* and the rear mount i[s] fixed with
11 the *top side of the offset hoisting apparatus.*”) (emphasis added); *id.* at cols. 7:7-10,
12 8:1-8).) Accordingly, the court concludes that Dr. Klopp’s opinion regarding the
13 improvement to the offset hoisting apparatus constitutes a new theory that was not
14 sufficiently disclosed in his Infringement Contentions. That claim 1 is written in Jepson
15 format does not relieve Mr. Schuyleman of his obligation to “disclose what in each
16 [A]ccused [Product] [he] contends practices each and every limitation of each asserted
17 claim[.]” *DCG Sys. v. Checkpoint Techs., LLC*, No. C 11-03792 PSG, 2012 WL
18 1309161, at *2 (N.D. Cal. Apr. 16, 2012); *see also* Local Patent Rules W.D. Wash. LPR
19 120(c) (requiring a patentee’s infringement contentions to “identify[] specifically where
20 each element of each Asserted Claim is found within each Accused Device”). Having
21 reviewed Mr. Schuyleman’s Infringement Contentions, the court agrees that he did not
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1 disclose his theory that the improvement—rather than the offset hoisting apparatus—has
2 the top, bottom, front, and rear side claim limitations.

3 Because Mr. Schuyleman did not act with diligence in amending his Infringement
4 Contentions, *see supra* at 16-18, the court will not permit Mr. Schuyleman to amend his
5 Infringement Contentions to reflect that the “improvement,” rather than the “offset
6 hoisting apparatus” has the claimed top, bottom, front, and rear sides. The court therefore
7 strikes this portion of Dr. Klopp’s report.

8 5. Dr. Klopp’s Alleged Identification of New Structures on the Accused Products

9 Barnhart also asserts that Dr. Klopp’s report offers new infringement theories with
10 respect to each of the Accused Products. (Klopp MTS at 11-18.) Specifically, Barnhart
11 argues that Mr. Schuyleman “leveraged ambiguity to his advantage” by “using
12 amorphous boxes and non-specific arrows in the Infringement Contentions” and
13 subsequently identifying the infringing structures as meeting the claim limitations in Dr.
14 Klopp’s report. (*See* Klopp MTS Reply at 8.) The court addresses each of Barnhart’s
15 arguments in turn.

16 *a. MOCCS*

17 In Barnhart’s view, Dr. Klopp’s report advances new infringement theories
18 regarding the “rigid boom” and “rear mount” limitations as applied to the MOCCS. (*Id.*
19 at 11.) Specifically, Barnhart contends that—as compared to Mr. Schuyleman’s
20 Infringement Contentions, which identified the “rigid boom” with a yellow arrow—Dr.
21 Klopp’s report identifies both the side beam *and* rear beam as the “rigid boom.” (*Id.* at
22 12 (referring to the highlighted structure in Dr. Klopp’s report).) Barnhart avers that the

1 rear beam, however, is an “entirely different component” from the side beam that was “in
2 no way subsumed by [Mr. Schuyleman’s] prior identification of the ‘rigid boom’” in the
3 Infringement Contentions. (Klopp MTS at 12.) Mr. Schuyleman responds that this
4 portion of Dr. Klopp’s report differs from the Infringement Contentions only because he
5 highlighted—rather than used an arrow—to identify the rigid boom in his report. (Klopp
6 MTS Resp. at 6.) Mr. Schuyleman asserts that Dr. Klopp’s report therefore does not
7 advance a new theory of infringement. (*See id.*)

8 The court finds that Dr. Klopp’s report does not set forth a new theory of
9 infringement with respect to the identification of the rigid boom or the rear beam.
10 Although the court agrees with Barnhart that the highlighted structures in Dr. Klopp’s
11 report identify additional or different components than what were identified by the arrow
12 and box in the Infringement Contentions, these changes are minor and do not alter Mr.
13 Schuyleman’s underlying argument that the MOCCS has a rigid boom and a rear mount.
14 *See Pavo Solutions LLC v. Kingston Tech. Co., Inc.*, No. 8:14-cv-01352-JLS-KES, 2019
15 WL 8138163, at *9-*10 (C.D. Cal. Nov. 20, 2019), *aff’d*, 35 F.4th 1367 (Fed. Cir. 2022)
16 (declining to strike expert’s report where the expert changed the position of arrows so
17 that they “point to . . . different structures”).

18 Barnhart advances similar arguments with respect to Dr. Klopp’s identification of
19 the “rear mount”—namely, that the Infringement Contentions identified the “rear mount”
20 on the MOCCS with a yellow box, whereas Dr. Klopp’s report identifies the “rear
21 mount” as a structure that would appear outside of the yellow box identified in the
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1 Infringement Contentions.¹⁶ (Klopp MTS at 12-13.) Mr. Schuyleman responds that a
2 review of the correct images in the Infringement Contentions reveals that Dr. Klopp’s
3 report identifies the same structure as the “rear mount.” (Klopp MTS Resp. at 6-7.)

4 Having reviewed the Infringement Contentions and the corresponding portions of
5 Dr. Klopp’s report, the court concludes that Dr. Klopp’s identification of the “rear
6 mount” does not substantially depart from the Infringement Contentions so as to have
7 deprived Barnhart of notice of what structure allegedly meets the “rear mount” limitation.
8 *See Pavo Solutions*, 2019 WL 8138163, at *9-*10. Moreover, Barnhart has not pointed
9 to any authority addressing the situation where the patentee failed to precisely identify
10 specific structures in its infringement contentions but does so in an expert report. *See*
11 *MLC Intell. Prop., LLC v. Micron Tech., Inc.*, No. 14-cv-03657-SI, 2019 WL 1865921, at
12 *2 (N.D. Cal. Apr. 25, 2019) (making the same observation). On this record, the court
13 concludes that “it would be improper to strike portions of Dr. [Klopp’s] report based
14 solely on the failure to disclose specific structures” in the Infringement Contentions. *See*
15 *id.*¹⁷

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19 ¹⁶ Barnhart states that it mistakenly included an image depicting the “front mount” in its
20 motion to strike, and provides the correct image in its reply brief. (Klopp MTS Reply at 7 n.1.)
Barnhart, however, maintains its argument that the Infringement Contentions “did not fully
disclose the ‘rear mount’ shown” in Dr. Klopp’s report. (*Id.*)

21 ¹⁷ In its reply, Barnhart argues that Dr. Klopp’s identification of the “front mount” on the
22 MOCCS also differs from the structure that was identified in the Infringement Contentions.
(Klopp MTS Reply at 7.) Because Barnhart did not make this argument in its opening brief, the
court does not consider it here. *See Zamani v. Carnes*, 491 F.3d 990, 997 (9th Cir. 2007).

1 *b. Mini-MOCCS*

2 Barnhart also avers that Dr. Klopp’s report advances new theories of infringement
3 regarding the “front mount” and “rear mount” limitations with respect to the Mini-
4 MOCCS. (Klopp MTS at 8.) In Barnhart’s view, Mr. Schuyleman’s Infringement
5 Contentions identify these structures on the Mini-MOCCS with yellow boxes “as
6 portions of an external, rectangular casing (outer tube)[.]” (*Id.*)

7 Mr. Schuyleman responds that Dr. Klopp has not identified new structures but has
8 “simply provided clearer indications of where the elements are found by highlighting the
9 relevant structures[.]” (Klopp MTS Resp. at 7.) He also asserts Dr. Klopp identifies the
10 same structures as the “front mount” and “rear mount” in his report as they are identified
11 in the Infringement Contentions. (*Id.* at 8.) While the Infringement Contentions are less
12 precise than Dr. Klopp’s expert report, the court concludes that the allegedly infringing
13 components were sufficiently identified in the Infringement Contentions to put Barnhart
14 on notice as to Mr. Schuyleman’s infringement theory.

15 Barnhart also contends that Dr. Klopp’s report opines, for the first time, that the
16 front and rear mounts are “section[s] of rectangular tube with an opening (aperture)
17 through which the rigid boom may travel.” (Klopp MTS at 14.) Barnhart also takes issue
18 with Dr. Klopp’s inclusion of a “cross-sectional analysis of the outer tube,” which
19 Barnhart contends departs from the Infringement Contentions by “identifying an actual
20 distinguishable area as an ‘aperture’ in contact with the ‘rigid boom.’” (*Id.*)

21 The court is not persuaded by Barnhart’s arguments. As Barnhart notes, the
22 Infringement Contentions expressly assert that both the front and rear mounts (identified

1 by yellow boxes) have “aperture[s]” which “confine[] the slidable movement of the boom
2 (identified by the yellow arrow).” (*Id.* at 13 (citing Infringement Contentions, Ex. 2, at 2,
3 4).) Dr. Klopp’s opinion that the front and rear mounts have “opening[s] (aperture[s])
4 through which the rigid boom may travel” and his identification of the alleged front and
5 rear booms in his report are therefore permissible applications of the theories set forth in
6 the Infringement Contentions. *Digit. Reg of Tex.*, 2014 WL 1653131, at *5 (“In patent
7 litigation, expert reports are expected to provide more information than is contained in
8 infringement contentions.”). Accordingly, the court declines to exclude this portion of
9 Dr. Klopp’s report.

10 *c. Mega-MOCCS*

11 Barnhart makes similar arguments with respect to Dr. Klopp’s identification of the
12 “rigid boom,” “front mount” and “rear mount” limitations on the Mega-MOCCS. (*See*
13 Klopp MTS at 15-16.) In Barnhart’s view, the Infringement Contentions identify the
14 rigid boom as the “innermost stage of a telescoping structure” whereas Dr. Klopp’s report
15 opines that the rigid boom “encompasses both the innermost and intermediate stages.”
16 (*Id.*) Barnhart also argues that Dr. Klopp’s report advances new infringement theories
17 regarding the alleged “front mount” and “rear mount” limitations on the Mega-MOCCS
18 “in nearly the same manner as with the Mini-MOCCS.” (Klopp MTS at 17 (emphasis
19 omitted); *see id.* at 18.) Mr. Schuyleman responds that Dr. Klopp’s opinions are not new
20 infringement theories but instead expound on the theories advanced in the Infringement
21 Contentions. (*See* Klopp MTS Resp. at 9.)
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1 The court rejects Barnhart’s arguments for the same reasons that it rejected these
2 arguments with respect to the Mini-MOCCS. Dr. Klopp’s opinion that the alleged front
3 and rear mounts of the Mega-MOCCS have front and rear apertures that “engage[] with
4 the perimeter of the boom and confine[] the boom to slidable movement in a telescoping
5 manner” (Klopp Report, App’x D at 16; *see id.* at 19), are permissible applications of the
6 theories set forth in the Infringement Contentions—namely, that the alleged front and
7 rear mounts of the Mega-MOCCS have respective front and rear boom aperture which
8 “confines the slidable movement of the boom[.]” (Infringement Contentions, Ex. 3 at 3,
9 4; *see also id.* at 5 (stating that the boom in the Mega-MOCCS may be “selectively slid
10 between a retracted and extended position”).)

11 Barnhart also takes issue with Dr. Klopp’s opinion that the Mega-MOCCS has
12 “two rigid booms.” (Klopp MTS at 16 (citing Klopp Report, App’x D at 14).) The court
13 has compared the images Barnhart identified in Mr. Schuyleman’s Infringement
14 Contentions and in Dr. Klopp’s report and concludes that Dr. Klopp does not advance a
15 new theory of infringement. (*See* Infringement Contentions, Ex. 3 at 2-3; Klopp Report
16 App’x D at 14 (figure 12).) Although Dr. Klopp’s report is more precise than the
17 Infringement Contentions, the components identified in the Infringement Contentions
18 provide Barnhart sufficient notice of Mr. Schuyleman’s infringement theory. The court
19 accordingly declines to strike Dr. Klopp’s report on this basis.

1 **D. Barnhart’s Motion to Exclude Mr. Morman’s Testimony**¹⁸

2 Mr. Schuyleman retained Mr. Morman to opine on the amount of reasonable
3 royalty damages necessary to compensate Mr. Schuyleman for Barnhart’s alleged
4 infringement of the ’244 Patent. (Morman Report (Dkt. # 91-2) at 4.) Below, the court
5 provides relevant background applicable to the calculation of reasonable royalty
6 damages, and then examines Mr. Morman’s opinions.

7 1. Reasonable Royalty Damages

8 Upon a finding of infringement, the patentee is entitled to “damages adequate to
9 compensate for the infringement, but in no event less than a reasonable royalty for the use
10 made of the invention by the infringer.” 35 U.S.C. § 284. A reasonable royalty amount
11 is typically determined using the hypothetical negotiation approach, which “attempts to
12 ascertain the royalty upon which the parties would have agreed had they successfully
13 negotiated an agreement just before infringement began.” *Lucent Techs., Inc. v.*
14 *Gateway, Inc.*, 580 F.3d 1301, 1324 (Fed. Cir. 2009). To determine the reasonable
15 royalty that would have been agreed to in a hypothetical negotiation, experts often
16 consider one or more of a non-exhaustive list of fifteen factors set forth in *Georgia-*
17 *Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116 (S.D.N.Y. 1970). *See*
18 *also Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1324 (Fed. Cir. 2009)
19 (approving the use of the *Georgia-Pacific* factors to determine reasonable royalties).

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21 ¹⁸ As fully explained in the court’s summary judgment order, the court grants summary
22 judgment in favor of Barnhart on its invalidity counterclaim. The parties’ arguments regarding
Barnhart’s motion to exclude Mr. Morman’s testimony do not undermine the court’s conclusion
that Barnhart is entitled to summary judgment on its invalidity counterclaim.

1 A reasonable royalty can take the form of a running royalty paid over time, or a
2 lump sum amount paid at one time. When an expert believes that a hypothetical
3 negotiation would have yielded a running royalty paid by the alleged infringer to the
4 patentee, “the classic way to determine the reasonable royalty is to multiple the royalty
5 base, which represents the revenue generated by the infringement, by the royalty rate,
6 which represents the percentage of revenue owed to the patentee.” *WhitServe, LLC*, 694
7 F.3d at 27. When the patented components do not make up the whole of the accused
8 products, and the patented feature does not drive the demand for the entire product, “the
9 ultimate combination of royalty base and royalty rate must reflect the value attributable to
10 the infringing features of the product, and no more.” *Ericsson, Inc. v. D-Link Sys., Inc.*,
11 773 F.3d 1201, 1226 (Fed. Cir. 2014).¹⁹ Additionally, to avoid “skew[ing] the damages
12 horizon for the jury[,]” the patentee must choose a royalty base that is not too high, and in
13 no event higher than the smallest salable patent-practicing unit, even if offset by a low
14 royalty rate. *Id.* at 1227 (quotations and citations omitted).

15 Under the Rule 702 analysis, “questions regarding which facts are most relevant
16 for calculating a reasonable royalty are properly left to a jury[.]” *Virnetx, Inc. v. Cisco*
17 *Sys., Inc.*, 767 F.3d 1308, 1329 (Fed. Cir. 2014). “[A] critical prerequisite, [however,] is
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20 ¹⁹ The parties agree that each of the Accused Products are “multi-component products,”
21 that each of the Accused Products have components that do not infringe the ’244 Patent, and that
22 some of the non-infringing components on each of the Accused Products drive demand in part
for the Accused Products. (Third RFA Resp. (Dkt. # 91-10), Nos. 136-47, 152-55.)

1 that the underlying methodology be sound.” *Id.* When the expert’s methodology is not
2 sound, exclusion of the expert’s opinion is proper. *Id.*

3 2. Mr. Morman’s Damages Opinions

4 Mr. Morman’s report offers a proposed reasonable royalty for the patents asserted
5 against Barnhart by Mr. Schuyleman.²⁰ (*See* Morman Report at 6.) To calculate a
6 reasonable royalty, Mr. Morman applied the *Georgia-Pacific* factors to a hypothetical
7 negotiation between Mr. Schuyleman and Barnhart. (*See id.* at 13-36.)

8 Barnhart contends that Mr. Morman’s application of the *Georgia-Pacific* factors
9 relies on “unsupported assumptions” and “ignores material facts.” (*See* Morman Mot. at
10 6; *see id.* at 8.) Specifically, Barnhart asserts that Mr. Morman’s opinions are unreliable
11 because (1) he improperly included non-infringing products in his royalty base; (2) he
12 fails to properly apportion the value of the patented components of the Accused Products;
13 (3) he improperly included convoyed sales in his analysis; (4) he fails to consider
14 evidence of licensing; and (5) he fails to consider non-infringing alternatives. (Morman
15 Mot. at 7-17.) The court examines each of these arguments in turn.

16 a. Royalty Base

17 Barnhart contends that Mr. Morman’s royalty base opinions are unreliable because
18 he inadvertently included the single beam MOCCS cantilever—a non-infringing
19

20 ²⁰ Because Mr. Schuyleman does not seek to recover lost profits, Mr. Morman performed
21 a reasonable royalty analysis. (Morman Report at 12; *see also* 2/12/25 Order (Dkt. # 96)
22 (granting stipulated motion dismissing Mr. Schuyleman’s claims for damages based on lost
profits).)

1 product—in the royalty base. (Morman Mot. at 11-12; Morman Reply at 5-6; *see* Dep. of
2 L. Morman (Dkt. # 91-3) (“Morman Dep.”) at 69:7-19.) Mr. Schuyleman does not
3 dispute that Mr. Morman included the non-infringing product in his proposed royalty
4 base. (*See* Morman Resp. at 3.) He asserts, however, that Mr. Morman’s royalty base
5 testimony should not be excluded because the non-infringing product was included due to
6 Barnhart’s “fail[ure] to keep appropriate records to differentiate between accused and
7 non-accused products.” (Morman Resp. at 3.)

8 As a general matter, “[t]he royalty base for reasonable royalty damages cannot
9 include activities that do not constitute patent infringement, as patent damages are limited
10 to those adequate to compensate for the infringement.” *Enplas Display Device Corp. v.*
11 *Seoul Semiconductor Co., Ltd.*, 909 F.3d 398, 411 (Fed. Cir. 2018) (quotations and
12 citations omitted); *see also* *Niazi Licensing Corp. v. St. Jude Med. S.C., Inc.*, 30 F.4th
13 1339, 1357 (Fed. Cir. 2022) (affirming exclusion of expert’s opinion when expert
14 improperly included non-infringing products in the royalty base). Mr. Morman stated
15 that he inadvertently included the non-accused “single beam [MOCCS] cantilever” in his
16 royalty base calculation because he “did not realize that there was a distinction” between
17 the Accused Products and the single beam MOCCS cantilever. (Morman Dep. at
18 69:7-19, 61:2-14.) Mr. Morman states that his royalty base calculation may need “an
19 adjustment” to account for the non-accused product. (*Id.* at 69:12-15; *see id.* at 39:4-11
20 (stating that the inclusion of the single beam hoist “may have an impact to the . . . royalty
21 base”); *id.* at 62:1-8 (“I agree an adjustment needs to be made to reflect . . . any jobs that
22 are using a non-accused product should be removed.”). It is not clear from Mr.

1 | Mormon's testimony, however, how much the royalty base should be adjusted after
2 | excluding the non-infringing products. (*See* Mormon Dep. at 69:15-19 ("At this time, I
3 | don't have sufficient information to make that [royalty base] adjustment as I'm not aware
4 | of which jobs that Barnhart performed services on that used . . . a single beam
5 | configuration.")).

6 | Mr. Schuyleman asserts that any "imprecision" in Mr. Mormon's report must be
7 | resolved against Barnhart. (Morman Resp. at 3 (citing *Sensonic, Inc. v. Aerosonic*
8 | *Corp.*, 81 F.3d 1566, 1573 (Fed. Cir. 1996)).) But Mr. Schuyleman bears the burden of
9 | establishing damages. *Dow Chem. Co. v. Mee Indus., Inc.*, 341 F.3d 1370, 1381 (Fed.
10 | Cir. 2003); *cf. Open Text S.A. v. Box, Inc.*, No. 13-CV-04910-JD, 2015 WL 349197, at *4
11 | (N.D. Cal. Jan. 23, 2015) (excluding expert testimony where expert failed to "refine data
12 | in other conventional ways"); *IP Innovation L.L.C. v. Red Hat, Inc.*, 705 F. Supp. 2d 687,
13 | 690 (E.D. Tex. 2010) (holding that plaintiff could not "shift the burden" of proving
14 | damages on defendants by "complaining that [defendants] did not provide sufficient
15 | information for [plaintiff's expert]" to calculate the royalty base). Mr. Schuyleman does
16 | not assert that Barnhart refused to provide data to identify which services were performed
17 | using non-accused products versus Accused Products. (*See generally* Mormon Resp.) To
18 | be sure, Barnhart's 30(b)(6) representative testified that Barnhart does not "keep track" of
19 | sales involving the single beam cantilever versus the Accused Products. (*See* Dep. of R.
20 | Kaercher (Dkt. # 105-1) ("Kaercher Dep.") at 137:8-12.) That representative also
21 | estimated, however, that the single beam system is used approximately "20 to 30 percent
22 | of the time." (*Id.* at 137:15-17.) At deposition, Mr. Mormon stated that he could not

1 update his royalty base calculation using these estimated figures because he “believe[s]
2 Barnhart knows precisely which jobs were quoted using a single beam cantilever[.]”
3 (Morman Dep. at 63:21-22; *see also id.* at 62:9-16 (stating that he “believe[s] there
4 should be sufficient information that should be produced of which we can accurately
5 identify which jobs where a single beam tool was used on”). At a minimum, however,
6 Mr. Morman could have updated his royalty base calculation to reflect the estimated
7 figure provided by Barnhart’s 30(b)(6) representative. Because Mr. Morman’s royalty
8 base includes non-infringing products, the court cannot conclude that his royalty base
9 opinions are premised on a reliable methodology.

10 *b. Apportionment*

11 Barnhart also asserts that Mr. Morman’s report is unreliable because he failed to
12 apportion the value of the infringing components of the Accused Products from the
13 non-infringing components of the Accused Products. (Morman Mot. at 8-11.) Mr.
14 Schuyleman disagrees. (Morman Resp. at 1.) Specifically, he argues that Mr. Morman
15 “acknowledged the law of apportionment in his report” by “devis[ing] an appropriate
16 mechanism” that accounts for the parties’ respective contributions to the Accused
17 Products. (*See* Morman Resp. at 1.)

18 Calculating reasonable royalty damages “is no small challenge where one
19 component [of the accused product] ‘may be covered by an asserted patent, while other
20 components are not.’” *Golden Bridge Tech. v. Apple Inc.*, No. 5:12-cv-04882-PSG, 2014
21 WL 2194501, at *5 (N.D. Cal. May 18, 2014) (quoting *LaserDynamics, Inc. v. Quanta*
22 *Computer, Inc.*, 694 F.3d 51, 75 (Fed. Cir. 2012)). In circumstances where the infringing

1 technology does not constitute the whole of the Accused Product, apportionment is
 2 required. *See Exmark Mfg. Co. Inc. v. Briggs & Stratton Power Prods. Grp., LLC*, 879
 3 F.3d 1332, 1348 (Fed. Cir. 2018). Apportionment can be addressed in a variety of ways,
 4 including “by careful selection of the royalty base to reflect the value added by the
 5 patented feature [or] . . . by adjustment of the royalty rate so as to discount the value of
 6 the product’s non-patented features; or by a combination thereof.” *Ericsson*, 773 F.3d at
 7 1226; *see also Commonwealth Scientific and Indus. Research Org. v. CISCO Sys. Inc.*,
 8 809 F.3d 1295, 1301 (Fed. Cir. 2015) (“[U]nder th[e] apportionment principle, ‘there
 9 may be more than one reliable method for estimating a reasonable royalty.’” (citation
 10 omitted)). “The essential requirement is that the ultimate reasonable royalty award must
 11 be based on the incremental value that the patented invention adds to the end product.”
 12 *Ericsson*, 773 F.3d at 1226. Here, because Mr. Morman did not apportion the value of
 13 the infringing and non-infringing components in the royalty base (*see* Morman Dep. at
 14 69:7-19; Morman Resp. at 3), he was required to account for apportionment in his royalty
 15 rate calculation.

16 Mr. Morman assesses the royalty rate as “[\$]4,000 per unit[.]”²¹ He states that the
 17 \$4,000 figure is based “only on the economic value of the patented technology[.]” (*See*
 18 Morman Report at 30.) Mr. Morman derives this figure from various documents
 19 produced by Barnhart reflecting a range of “internal charge[s] (before [a] 50% markup)”

20
 21 ²¹ The court observes that in various points in his report, Mr. Morman defines the
 22 proposed royalty rate as “\$4,000 per use[.]” \$4,000 per unit[.]” and “\$4,000 per day as a starting
 point for [his] basis of a per-unit royalty.” (Morman Report at 33, 35, 32.) It is therefore unclear
 which basis of measurement he relies on in forming his reasonable royalty opinions.

1 for use of the Accused Products. (*Id.* at 32 n.102.) Mr. Morman selected \$4,000 as the
 2 base price, “[t]o be conservative,” because he believed that amount “was more of the
 3 lower end of th[e] range” of internal charges. (Morman Dep. at 128:2-22.)²² Mr.
 4 Morman asserts that “Barnhart’s contributions” to the Accused Products—i.e., the non-
 5 infringing components—are reflected in the 50% markup and are not included in the
 6 \$4,000 base price. (*Id.* at 144:2-15; Morman Report at 32.) He further asserts his
 7 methodology serves as an effective substitute for apportionment because it “capture[s]
 8 the expectation that Mr. Schuyleman would expect to receive” from Barnhart’s use of the
 9 Accused Products and “account[s] for an economic consideration in return for Barnhart’s
 10 contributions” to the Accused Products. (Morman Dep. at 147:15-148:11.)

11 The court agrees with Barnhart that Mr. Morman’s analysis does not adequately
 12 apportion between the infringing and non-infringing components of the Accused
 13 Products. Mr. Morman asserts that his approach accounts for the non-infringing
 14 components because Barnhart “earn[s] a significant return on their contributions” to the
 15 Accused Products “by way of the markups[.]” (*See id.* at 145:16-146:9; *see also id.* at
 16 144:4-6 (stating that “[t]he factors that would be unrelated to the patented technology
 17 would be reflective in the markups”).) From this, Mr. Morman opines that “as long as
 18

19 ²² Mr. Morman also contends that \$4,000 is “typically an internal type of charge for
 20 similar equipment” in the industry. (Morman Dep. at 128:1-129:14.) But courts have rejected an
 21 expert’s deriving of a royalty rate by choosing a starting point based on industry-wide data as an
 22 alternative to the specific facts of the case. *See VirnetX*, 767 F.3d at 1331-34; *Dynetix Design Solutions, Inc. v. Synopsys, Inc.*, No. C 11-05973 PSG, 2013 WL 4538210, at *4-*5 (N.D. Cal. Aug. 22, 2013). Accordingly, the industry standards cannot alone support Mr. Morman’s proposed royalty rate.

1 [Barnhart] [is] earning a return on their investment that should cover . . . their
2 contributions to” the Accused Products. (*Id.* at 147:4-7.) But Mr. Morman never
3 explains how he knows that all of Barnhart’s contributions to the Accused Products are
4 reflected in the markups and that the markups do not include infringing components.
5 Indeed, the Barnhart documents that Mr. Morman relies on merely provide that Barnhart
6 charges a premium for use of its cantilever equipment—and that Barnhart expects to earn
7 a gross profit margin plus markup on the use of its equipment. (*See* Morman Report at
8 31-32; *id.* n.101; *id.* at 24.) While “estimating a reasonable royalty is not an exact
9 science[,] . . . the data utilized in the methodology [must be] sufficiently tied to the facts
10 of the case.” *Summit 6, LLC v. Samsung Elecs. Co.*, 802 F.3d 1283, 1296 (Fed. Cir.
11 2015).

12 Mr. Schuyleman likens Mr. Morman’s methodology to that of the expert in
13 *Carucel Investments, L.P. v. Novatel Wireless, Inc.*, No. 16-cv-118-H-KSC, 2017 WL
14 1215838 (S.D. Cal. Apr. 3, 2017). (Morman Resp. at 2.) In that case, the plaintiff
15 challenged the defendant’s damages expert’s apportionment methodology as unreliable.
16 *See Carucel*, 2017 WL 1215838 at *3-*4. As relevant here, that expert applied a “price-
17 based apportionment” method in which he reduced the proposed royalty base by
18 comparing the price of later models of the alleged infringing products to the original
19 value of non-infringing components. *Id.* Specifically, the expert’s apportionment
20 method was “based on the ratio of the first accused [] device . . . divided by the observed
21 average sales price over time.” *Id.* at *6. The expert explained that this method
22 “allow[ed] for removal of non-infringing functionality that has been added to the

1 products over time, which improve the products['] value but do not relate to the patents-
2 in-suit.” *Id.* The *Carucel* court concluded that the expert provided a “reasonable
3 explanation” for his apportionment and declined to exclude his testimony. *Id.* Here, in
4 contrast, Mr. Morman does not provide any explanation for *how* his apportionment
5 analysis removes the non-infringing components of the Accused Products. (*See generally*
6 Morman Report; *see* Morman Dep. at 129:15-19 (stating that he did not perform
7 additional analysis or calculation “[b]eyond what is stated in [his] report” to arrive at the
8 \$4,000 royalty rate).) Accordingly, Mr. Morman’s report and testimony must be
9 excluded. *See MLC Intell. Prop., LLC v. Micron Tech., Inc.*, 10 F.4th 1358, 1375 (Fed.
10 Cir. 2021) (excluding damages expert’s opinion for failure to apportion).

11 The court reiterates that, to be admissible, an expert’s testimony must be the
12 product of reliable principles and methods applied to sufficient facts or data. Fed. R.
13 Evid. 702(d). To this end, district courts, as gatekeepers, must ensure that all expert
14 testimony is rooted in firm scientific or technical ground. *Daubert*, 509 U.S. at 589-90;
15 *Kumho*, 526 U.S. at 148. A “critical prerequisite” to the admission of a damages expert’s
16 reasonable royalty “is that the underlying methodology must be sound.” *Virnetx*, 767
17 F.3d at 1329. A patent damages expert’s failure to apportion the royalty base and the
18 royalty rate renders his reasonable royalty analysis unreliable. *See MLC Intell. Prop.*,
19 *LLC v. Micron Tech., Inc.*, No. 14-CV-03657-SI, 2019 WL 3070567, at *4 (N.D. Cal.
20 July 12, 2019), *aff’d*, 10 F.4th 1358 (Fed. Cir. 2021); *see also Virnetx*, 767 F.3d at 1329
21 (excluding royalty base testimony as inadmissible for failure to apportion). Because the
22 court concludes that Mr. Morman’s reasonable royalty analysis is fundamentally flawed

1 both as to the royalty base and the royalty rate, the court need not address Barnhart's
2 challenges to Mr. Morman's opinions regarding conveyed sales, licensing, and non-
3 infringing alternatives. *See MLC Intell. Prop.*, 2019 WL 3070567 at *4 (excluding
4 entirety of patent damages expert's opinion as unreliable for failure to apportion the
5 royalty rate and the royalty base).

6 **E. Mr. Schuyleman's Motion to Exclude Mr. Perkin's Testimony**

7 Barnhart retained Mr. Perkin to opine on the issues of invalidity and non-
8 infringement. (Perkin Op. Report (Dkt. # 93-2) at 5; Perkin Reb. Report (Dkt. # 93-3) at
9 5.) Mr. Schuyleman asserts that Mr. Perkin's testimony should be excluded because he
10 (i) improperly construes claim terms; (ii) fails to specify whether the claims at issue are
11 apparatus or method claims; (iii) fails to distinguish between anticipation and
12 obviousness in his discussion of prior art; (iv) fails to advance consistent written
13 description and enablement arguments with respect to certain claim terms; and (v) fails to
14 support certain indefiniteness opinions. (*See* Perkin Mot. at 4-12.) The court addresses
15 these arguments below.

16 **1. Alleged Improper Claim Construction**

17 Mr. Schuyleman contends that Mr. Perkin improperly construes both terms that
18 were not construed by the court and terms that the court already construed in its claim
19 construction order. (Perkin Mot. at 4.) Barnhart responds that Mr. Perkin applied the
20 plain and ordinary meaning of non-construed terms, and uses the court's claim
21 constructions to apply the construed terms. (Perkin Resp. at 6.) The court examines the
22 parties' respective arguments in turn.

1 *a. Alleged Improper Claim Construction of Non-Construed Terms*

2 Mr. Schuyleman contends that Mr. Perkin improperly construed the terms “hook
3 means” and “clamping means[,]” neither of which were identified by the parties as
4 disputed claim terms or construed by the court in its claim construction order. (Perkin
5 Mot. at 5-6; *see generally* CC Order.) In response, Barnhart asserts that the term
6 “means” in “hook means” and “clamping means” triggers the rebuttable presumption that
7 those claim limitations are means-plus-function limitations and that Mr. Perkin properly
8 applied the presumption. (*See* Perkin Resp. at 11.) Barnhart further asserts that Mr.
9 Schuyleman has not demonstrated that Mr. Perkin’s application of the rebuttable
10 presumption renders his testimony unreliable or irrelevant. (*Id.*)

11 The construction of claims is within the province of the court. *Markman v.*
12 *Westview Instruments, Inc.*, 517 U.S. 370, 387 (1996). Parties may introduce evidence as
13 to the *plain and ordinary* meaning of non-construed terms at trial “as long as the
14 evidence does not amount to arguing claim construction to the jury.” *Icon-IP Pty Ltd.*, 87
15 F. Supp. 3d at 945. That is because “the risk of confusing the jury is high when experts
16 opine on claim construction.” *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319,
17 1337 (Fed. Cir. 2009). Accordingly, expert testimony that includes improper claim
18 construction arguments must be excluded. *Icon-IP Pty Ltd.*, 87 F. Supp. 3d at 945; *see*
19 *Cordis Corp. v. Bos. Sci. Corp.*, 561 F.3d 1319, 1337 (Fed. Cir. 2009) (affirming district
20 court’s exclusion of expert’s claim construction arguments before the jury). The court
21 assesses Mr. Perkin’s opinions regarding the terms “hook means” and “clamping means”
22 with these principles in mind.

1 As to the term “hook means[,]” Mr. Perkin opines:

2 Claim 1 includes the term “hook means”, which I understand is a means plus
3 function limitation that invokes 35 U.S.C. § 112 ¶ 6. Accordingly, I have
4 interpreted claim 1 to cover structure, materials, or acts in the specification,
and equivalents thereof, which correspond to the term “hook means”.

5 (Perkin Op. Report ¶ 83; Perkin Reb. Report ¶ 90.) Mr. Schuyleman asserts that this
6 constitutes an “improper constru[ction]” of the term “hook means” that “usurps” the role
7 of the court. (Perkin Mot. at 5; *see* Perkin Reply at 1-2.) Barnhart contends that Mr.
8 Perkin’s “hook means” opinions are merely an application of the rebuttable presumption.
9 (See Perkin Resp. at 11-12.) The court agrees with Mr. Schuyleman that Mr. Perkin’s
10 “hook means” testimony constitutes improper claim construction. “The task of
11 determining whether [a] limitation in question should be regarded as a means-plus-
12 function limitation” is a claim construction issue within the province of the court. *Kemco*
13 *Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1360 (Fed. Cir. 2000) (“Whether the
14 language of a claim is to be interpreted according to 35 U.S.C. § 112, ¶ 6, i.e., whether a
15 claim limitation is in means-plus-function format, is a matter of claim construction.”).
16 Mr. Perkin admits that he used his own construction of “hook means” in connection with
17 his opinions regarding infringement, obviousness, and anticipation. (Perkin Mot., Ex. D
18 (“Perkin Dep.”) at 160:3-6, 115:15-24, 114:8-18, 119:14-120:10, 122:5-23, 124:10-
19 125:8.) Accordingly, the court concludes that the challenged portions of Mr. Perkin’s

1 testimony that include these improper claim constructions must be excluded.²³ *See Icon*,
2 87 F. Supp. at 945.

3 As to the term “clamping means[,]” Mr. Perkin opines:

4 Claims 12 and 13 each include the term “clamping means”, which I
5 understand is a means plus function limitation that invokes 35 U.S.C. § 112
6 ¶ 6. Accordingly, I have interpreted claims 12 and 13 to cover structure,
7 materials, or acts in the specification, and equivalents thereof, which
8 correspond to the term “clamping means”. My opinion is that only one such
9 “clamping means” is disclosed: at least one bolt and a nut . . . Accordingly, I
10 have interpreted the term “clamping means” in claims 12 and 13 to refer to
11 “at least one bolt and nut”, and only to “at least one bolt and nut”.

12 (Perkin Op. Report ¶¶ 84-85; Perkin Reb. Report ¶¶ 91-92.) Mr. Perkin also used his
13 construction of this term in developing his opinions on non-infringement, and for his
14 opinions of certain prior art references. (*See* Perkin Dep. at 160:7-11, 115:25-116:5,
15 117:3-8, 120:6-10, 121:9-14, 122:24-123:5, 124:3-9, 125:10-16, 126:19-127:1.) Barnhart
16 does not dispute that Mr. Perkin used his own construction of “clamping means,” but
17 asserts that the term need not be construed because Mr. Schuyleman no longer asserts
18 claims 12 and 13. (Perkin Resp. at 11.) He also argues that Mr. Perkin’s “clamping
19 means” opinions should not be excluded because his opinions merely apply the rebuttable
20 presumption that “clamping means” is a means-plus-function limitation. (*See id.* at n.1.)
21 Because the question of whether a claim limitation is in means-plus-function format is a
22 matter of claim construction, however, the court concludes that the portions of Mr.

²³ Barnhart argues Mr. Perkin’s interpretation did not ultimately impact his assessment of whether the prior art included a “hook means.” (Perkin Resp. at 11-12.) Because the court cannot determine how Mr. Perkin’s use of his construction impacted his analysis, this portion of his opinion must be excluded.

1 Perkin’s testimony that include these improper claim constructions must be excluded.

2 *See Icon*, 87 F. Supp. at 945.

3 Barnhart contends that the terms “hook means” and “clamping means” may still be
4 construed by the court at this stage. (*See* Perkin Resp. at 10-11 (citing cases).) It is true
5 that the court “retains discretion to hear belated claim construction arguments” after the
6 *Markman* hearing. *Stern v. SeQual Techs., Inc.*, 840 F. Supp. 2d 1260, 1266 (W.D.
7 Wash. 2012), *aff’d*, 493 F. App’x 99 (Fed. Cir. 2012). The Federal Circuit, however, has
8 upheld a district court’s decision not to entertain untimely claim construction arguments
9 made after the relevant disclosure deadlines under the applicable local patent rules. *See*
10 *SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1292 (Fed. Cir. 2005)
11 (considering the Northern District of California’s local patent rules). This District’s
12 Local Patent Rules require the disclosure of all terms governed by 35 U.S.C. § 112 ¶ 6
13 “within 20 days of service of the contentions.” Local Patent Rules W.D. Wash. LPR
14 130(a). Barnhart did not raise these terms for construction in its contentions or in
15 connection with the *Markman* hearing, nor does it make any argument as to why the court
16 should construe them now. (*See generally* Perkin Resp. at 10-11.) Barnhart had ample
17 opportunity to seek construction of the “hook means” and “clamping means” terms. *See*
18 *Battcher Indus., Inc. v. Bunzl USA, Inc.*, 661 F.3d 629, 640-41 (Fed. Cir. 2011) (affirming
19 district court’s holding that “[defendant] could not add new claim construction theories
20 on the eve of trial” when defendant failed to seek construction earlier). Accordingly, the
21 court declines to construe these terms at this stage of the litigation. *See SanDisk*, 415
22 F.3d at 1292 (“[T]his court gives broad deference to the trial court’s application of local

1 procedural rules in view of the trial court’s need to control the parties and flow of
2 litigation before it.”) (citation omitted).

3 *b. Alleged Relitigation of Construed Claims*

4 Mr. Schuyleman argues that Mr. Perkin attempts to relitigate certain claim
5 constructions or interprets claim terms inconsistently with the court’s constructions.
6 (Perkin Mot. at 6-7; Perkin Reply at 2-3.) Barnhart asserts that Mr. Perkin’s proposed
7 interpretations are consistent with the court’s claim constructions. (Perkin Resp. at 6-7.)
8 The court first discusses the relevant legal background, and then examines the parties’
9 arguments.

10 *i. Relevant Legal Background*

11 A court’s claim construction is the “law of the case” for purposes of trial.
12 *Andersen Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1371 n.2 (Fed. Cir. 2007); *see*
13 *also Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1321 (Fed. Cir. 2009)
14 (“Once a district court has construed the relevant claim terms, and unless altered by the
15 district court, then that legal determination governs for purposes of trial.”). Thus, “[a]ny
16 expert testimony must adhere to the court’s claim constructions and must not apply
17 alternative claim constructions.” *Dynetix Design*, 2013 WL 4537838, at *4. An expert
18 may, however, “offer an opinion on how a court’s claim construction should be applied to
19 the facts of the case.” *Pelican Int’l, Inc. v. Hobie Cat Co.*, 655 F. Supp. 3d 1002, 1027
20 (S.D. Cal. 2023); *see also Asetek Danmark A/S v. CoolIT Sys. Inc.*, No. 19-CV-00410-
21 EMC, 2022 WL 21306657, at *8 (N.D. Cal. Oct. 4, 2022) (noting that “[t]he implications
22

1 of the Court’s constructions are matters on which the parties’ experts may opine”)
 2 (citation omitted)).

3 *ii. “Largely Inflexible”*

4 Mr. Schuyleman asserts that Mr. Perkin attempts to relitigate the phrase “largely
 5 inflexible” in his report. (Perkin Mot. at 6-7; Perkin Reply at 2-3.) During the claim
 6 construction phase, Mr. Perkin opined that the claim term “rigid boom” should be
 7 construed to mean “a uniform, linear support arm having a fixed length.” (Perkin CC
 8 Decl. (Dkt. # 61-4) at 19; *see also* Barnhart CC Op. (Dkt. # 63) at 11 (advancing Mr.
 9 Perkin’s proposed construction).) The court ultimately rejected the proposed “fixed
 10 length” limitation and instead construed the term “rigid boom” to mean “a beam that is
 11 largely inflexible.” (CC Order at 6-7; *see also id.* at 5 (“The court agrees with Mr.
 12 Schuyleman that the term [rigid boom] does not require ‘having a fixed length’ and
 13 adopts the following construction: ‘a beam that is largely inflexible’”).) In Mr. Perkin’s
 14 expert reports, he interprets the phrase “largely inflexible” as follows:

15 I am interpreting this term to mean either inflexible in percentage or
 16 inflexible in degree. Specifically, I have interpreted this term, as applied to
 17 the claim term “rigid boom” to mean, on one hand, that the entirety of the
 rigid boom is mostly inflexible, and on the other hand, to mean that the
 majority of the volume (*or length*) of the rigid boom is inflexible.

18 (Perkin Op. Report ¶ 78; Perkin Reb. Report ¶ 85 (emphasis added by Mr. Schuyleman).)

19 According to Mr. Schuyleman, Mr. Perkin’s interpretation of “largely inflexible” is an
 20 attempt to relitigate his proposed “fixed length” construction. (Perkin Mot. at 6-7.)
 21 Barnhart contends that Mr. Perkin’s expert reports do not opine on the length of the
 22 boom, or whether it is fixed or variable. (Perkin Resp. at 7.) The court agrees with

1 Barnhart. In his opening report, Mr. Perkin explicitly states that “the definition of ‘rigid
2 boom’ *does not impose any limitations on the boom with respect to length or variability.*”
3 (Perkin Op. Report ¶ 379 (emphasis added).) The court does not understand Mr. Perkin
4 to attempt to relitigate the proposed “fixed length” construction.²⁴ Accordingly, the court
5 declines to exclude this portion of Mr. Perkin’s testimony.

6 *iii. “Front Mount” and “Rear Mount”*

7 Mr. Schuyleman also asserts that Mr. Perkin attempts to relitigate the court’s
8 constructions of the terms “front mount” and “rear mount.” (Perkin Mot. at 7; Perkin
9 Reply at 3.) During the claim construction phase, Barnhart proposed that these terms be
10 construed as “‘a support structure disposed between the center of gravity and the distal
11 end of the rigid boom’ / ‘a support structure disposed between the center of gravity and
12 the proximal end of the rigid boom.’” (Barnhart CC Op. at 12-13.) The court rejected
13 Barnhart’s proposed construction, and instead construed “front mount” as “the mount
14 closest to the distal end of the rigid boom” and “rear mount” as “the mount closest to the
15 proximal end of the rigid boom.” (CC Order at 7.) In his report, Mr. Perkin interprets the
16 term “mount” to mean “any structure which supports, or provides upward force on, a
17 suspended beam or ‘rigid boom[.]’” (Perkin Op. Report ¶ 81; Perkin Reb. Report ¶ 88.)
18 In Mr. Schuyleman’s view, Mr. Perkin’s interpretation of “mount” attempts to

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20 ²⁴ Mr. Schuyleman contends that Mr. Perkin’s opinions regarding the term “largely
21 inflexible” should be excluded because Mr. Perkin testified at deposition that his interpretation of
22 “largely inflexible” in his report does not differ from his proposed “fixed length” construction.
(Perkin Mot. at 7 (citing Perkin Dep. 36:24-38:15).) Because Mr. Perkin’s report specifies that
the term “rigid boom” “does not impose any limitations on the boom with respect to length or
variability[.]” the court declines to exclude his opinion on this basis.

1 “resurrect[] Barnhart’s proposed construction” of the terms as “support structure[s].”
2 (Perkin Mot. at 7.) Barnhart responds that the court rejected Barnhart’s proposed “center
3 of gravity” limitation, but not its “support structure” limitation in its claim construction
4 order, and that Mr. Perkin’s testimony is “entirely consistent” with the court’s
5 construction because it does not reference the “center of gravity” limitation. (*See* Perkin
6 Resp. at 8-9; CC Order at 7 (“The court agrees . . . that Barnhart’s proposed ‘*center of*
7 *gravity*’ limitation is inappropriate.”) (emphasis added).)

8 The court agrees with Mr. Schuyleman that Mr. Perkin’s interpretation exceeds the
9 bounds of the court’s claim construction. In its claim construction order, the court settled
10 the parties’ disputes regarding the “front mount” and “rear mount” by adopting the plain
11 and ordinary meaning of those terms and notably did not adopt Barnhart’s proposed
12 “support structure” limitation. (*See* CC Order at 7.) The court therefore concludes that
13 Mr. Perkin’s opinions interpreting “front mount” and “rear mount” as “structure[s] which
14 support[], or provide[] upward force” to a rigid boom must be excluded.

15 Mr. Schuyleman also contends that Mr. Perkin’s opinions regarding the terms
16 “front mount” and “rear mount” are inconsistent with the court’s construction because he
17 interprets the phrases “the mount closest to the proximal[/distal] end of the rigid boom”
18 to include the limitation “during each stage of the operation.” (Perkin Mot. at 8 (citing
19 Perkin Op. Report ¶ 79; Perkin Reb. Report ¶ 86).) For the reasons discussed below, the
20 court reserves ruling on this argument.

21 Here, Barnhart notes that the ’244 Patent “claims a rigid boom with distal and
22 proximate ends, which slidably moves from a ‘retracted position’ to an ‘extended

1 position' through apertures in the 'front mount' and 'rear mount.'" (Perkin Resp. at 9
2 (citing '244 Patent at 6:2-23).) Barnhart asserts that Mr. Perkin applied the court's
3 construction of "front mount" and "rear mount" in his reports and "considered whether
4 movement of the distal and proximal ends of the rigid boom through the mounts would
5 alter whether a given device falls within the [c]ourt's construction." (*Id.*) Barnhart
6 further asserts that Mr. Perkin used the phrase "during each stage of the operation" "to
7 describe his understanding that the [c]ourt provided *no* limitation on [the] relative
8 location of the 'front mount' and 'rear mount' during operation." (*Id.* (emphasis in
9 original).)

10 The court agrees with Mr. Schuyleman that the opinions Mr. Perkin offers at trial
11 must adhere to the court's claim constructions. To the extent that Mr. Schuyleman
12 simply disagrees with Mr. Perkin's application of the court's construction to the facts of
13 this case, however, that is not a proper basis for exclusion of his testimony. *See Pelican*,
14 655 F. Supp. 3d at 1027; *see also Elosu*, 26 F.4th at 1024 ("Ultimately, 'the test under
15 *Daubert* is not the correctness of the expert's conclusions but the soundness of his
16 methodology.'"). The court concludes that Mr. Schuyleman's concerns would be more
17 appropriately addressed through a contemporaneous objection at trial rather than
18 preclusion of Mr. Perkin's testimony on this point. *See Carucel*, 2017 WL 1215838, at
19 *17.

20 *iv. "Forward and Backward Movement"*

21 Mr. Schuyleman also argues that Mr. Perkin's opinions regarding the phrase
22 "forward and backward movement" should be excluded as inconsistent with the court's

1 claim construction order. (Perkin Mot. at 8.) As relevant here, the court construed the
2 term “confining the boom” to mean “restricting the boom to forward and backward
3 movement.” (CC Order at 10.) The court did not construe “forward and backward
4 movement” in its claim construction order. (*See id.*) In his reports, Mr. Perkin interprets
5 “forward and backward movement” to mean “that both the ‘front boom aperture’ and
6 ‘rear boom aperture’ restrict the boom to only be movable in a forward or backward
7 direction as measured along the primary axis of the boom—i.e., along the longitudinal or
8 axial length of the boom.” (Perkin Op. Report ¶ 80; Perkin Reb. Report ¶ 87.) In
9 response, Barnhart asserts that Mr. Perkin applied the court’s construction of “forward
10 and backward movement” and “explains how a POSITA would orient such movement
11 relative to the ‘rigid boom[.]’” (Perkin Resp. at 10.)²⁵ Mr. Schuyleman does not respond
12 to this argument in his reply. (*See generally* Reply.) “Where parties do not seek
13 construction of a term, the words are given their ordinary and customary meaning: ‘the
14 meaning that the term would have to a person of ordinary skill in the art in question at the
15 time of the invention.’” *Contour IP Holding, LLC v. GoPro, Inc.*, No. 3:17-CV-04738-
16 WHO, 2020 WL 5106845, at *4 (N.D. Cal. Aug. 31, 2020). In these circumstances,
17 experts may “present evidence about how a POSITA would understand a term,” so long
18 as such opinions do not make claim construction arguments to a jury. *Id.* The court does

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20 ²⁵ Mr. Perkin states that he “made this judgment call out of necessity for [his] analysis of
21 the Asserted Claims against the prior art” because “a POSITA would not necessarily be able to
22 discern with certainty the meaning . . . ‘forward and backward movement’ [as it is] not defined
relative to the ‘front mount’ or the ‘rear mount,’ [or] with respect to a longitudinal, or
lengthwise, axis of the ‘rigid boom.’” (Perkin Op. Report ¶ 382.)

1 not understand Mr. Perkin's interpretation to amount to claim construction. Accordingly,
2 the court declines to exclude this portion of his report.

3 2. Apparatus or Method Claims

4 Mr. Schuyleman also challenges Mr. Perkin's opinions on the basis that his reports
5 do not "state[] whether the claims at issue in this case are method claims or apparatus
6 claims."²⁶ (Perkin Mot. at 8.) When asked at deposition whether claim 1 of the Asserted
7 Patent was an apparatus claim, Mr. Perkin responded that he had "not heard of an
8 apparatus claim, but [the claim] does have to do with an apparatus." (Perkin Dep. at
9 161:23-162:8.) Mr. Schuyleman contends that Mr. Perkin's "[in]ab[ility] to identify what
10 kind of claims are at issue in this case" renders his opinions unreliable because the tests
11 for infringement are distinct for apparatus and method claims. (Perkin Mot. at 9 (citing
12 cases).) Barnhart counters that Mr. Perkin properly analyzed the claims as apparatus
13 claims. (Perkin Resp. at 14.) Barnhart further contends that Mr. Schuyleman's
14 challenges are based on Mr. Perkin's patent law knowledge, rather than his area of
15 expertise, and are therefore improper. (*Id.*) In reply, Mr. Schuyleman responds that "[i]f
16 Mr. Perkin had anal[]yzed the claims as Apparatus claims, certainly he could have said
17 so." (Perkin Reply at 6.)

18 Mr. Perkin's area of expertise is in mechanical engineering. (*See* Perkin Report at
19 6.) Barnhart retained Mr. Perkin to provide opinions regarding invalidity and non-
20 infringement. (*See generally* Perkin Op. Report; Perkin Reb. Report.) Mr. Schuyleman

21 ²⁶ The parties agree that the claim at issue is an apparatus claim. (Perkin Mot. at 8 n.4;
22 Perkin Resp. at 14.)

1 does not challenge Mr. Perkin’s knowledge or skill as they relate to his field of expertise.
2 (*See generally* Perkin Mot.; Perkin Reply.) And Mr. Schuyleman’s challenges regarding
3 Mr. Perkin’s patent law knowledge do not undermine his testimony because Mr. Perkin
4 was not retained as a patent law expert. (*See* Perkin Op. Report ¶ 27 (“I have not been
5 asked to offer opinions on the law”); *see also WNS Holdings, LLC v. United Parcel Serv.,*
6 *Inc.*, No. 08-CV-275-BBC, 2009 WL 2136961, at *4 (W.D. Wis. July 14, 2009), *aff’d*,
7 368 F. App’x 144 (Fed. Cir. 2010) (denying motion to exclude avionics expert’s non-
8 infringement and invalidity opinions despite plaintiff’s challenges to his “lack of
9 expertise in patent law”); *Niazi Licensing Corp. v. St. Jude Med. S.C., Inc.*, No. 17-CV-
10 5096 (WMW/BRT), 2020 WL 5512507, at *5 (D. Minn. Sept. 14, 2020), *aff’d*, 30 F.4th
11 1339 (Fed. Cir. 2022) (denying motion to exclude where plaintiff challenged expert’s
12 ability to explain and understand the difference between direct and indirect
13 infringement”). As Barnhart points out, Mr. Perkin explained his understanding of
14 certain infringement and invalidity principles and appears to apply his understanding in
15 developing his opinions. (Perkin Resp. at 14 (citing Perkin Op. Report ¶¶ 27-57, 97-383;
16 Perkin Reb. Report ¶¶ 29-56, 129-274).) Mr. Perkin also opines that the ’244 Patent is
17 “directed to an apparatus for use with a crane[.]” (Perkin Op. Report ¶ 58 (internal
18 quotations and citation omitted).) Mr. Schuyleman does not provide any examples from
19 Mr. Perkin’s report demonstrating that he incorrectly analyzed the claims as method
20 claims. (*See generally* Perkin Mot.; Perkin Reply.) Accordingly, the court declines to
21 exclude Mr. Perkin’s testimony on this basis.
22

1 3. Anticipation and Obviousness

2 Mr. Schuyleman contends that Mr. Perkin’s opinions regarding anticipation with
3 respect to the Wheeler prior art reference²⁷ should be excluded because he failed to
4 distinguish between the legal standards for anticipation and obviousness. (Perkin Mot. at
5 9.) Specifically, Mr. Schuyleman challenges the following portion of Mr. Perkin’s
6 opinion:

7 Thus, in my opinion, the Asserted Claims of the ’244 Patent ***are anticipated***
8 ***by Wheeler under 35 U.S.C. § 102 or are rendered obvious by:*** (i) Wheeler
9 alone; and (ii) Wheeler in view of the additional art discussed below and in
10 the claim charts attached to Barnhart’s Contentions, under 35 U.S.C. § 103.

11 (Perkin Op. Report ¶ 200 (emphasis added).) Mr. Schuyleman contends that Mr. Perkin’s
12 opinion is “legally wrong” because he states that certain claim elements are not present in
13 the Wheeler reference, while simultaneously opining that the ’244 Patent is anticipated
14 under the Wheeler reference. (See Perkin Mot. at 9.) As Mr. Schuyleman notes, “[a]
15 finding of anticipation requires clear and convincing evidence that each and every
16 element is found within a single prior art reference, arranged as claimed.” (Perkin Mot.
17 at 3) (quoting *ATEN Int’l Co. v. Uniclass Tech. Co.*, 932 F.3d 1364, 1368 (Fed. Cir.
18 2019) (internal quotation and citation omitted)). Barnhart states that Mr. Perkin’s
19 statement regarding anticipation with respect to the Wheeler reference was a “scrivener’s
20 error[.]” (Perkin Resp. at 15; see *id.* (characterizing this portion of Mr. Perkin’s

21 ²⁷ In discussing the Wheeler prior art reference, the parties refer to U.S. Patent No.
22 3,675,961. (See Perkin Op. ¶ 149.) That patent is titled “Horizontal Load Positioner” and
describes a “horizontal load positioner to facilitate depositing a load within or removing a load
from an opening in a building with the aid of a hoist line[.]” (’961 Patent at 8:70-73.)

1 testimony as a “harmless misstatement”).) Barnhart posits that this “misstatement . . . has
2 no bearing on [Mr.] Perkin’s testimony” regarding obviousness. (*Id.*)

3 The parties agree that Mr. Perkin’s anticipation opinions with respect to the
4 Wheeler reference are improper. (Perkin Mot. at 9; Perkin Resp. at 15.) The court
5 therefore concludes Mr. Perkin’s anticipation opinions regarding that prior art reference
6 must be excluded.²⁸

7 4. “Offset Hoisting Apparatus” and “Therethrough”

8 Mr. Schuyleman argues that Mr. Perkin’s testimony opining that the terms “offset
9 hoisting apparatus” and “therethrough” lack written description and enablement should
10 be excluded. (Perkin Mot. at 10-12.) Each of these arguments is addressed below.

11 a. *“Offset Hoisting Apparatus”*

12 Mr. Schuyleman asserts that Mr. Perkin advances two inconsistent positions
13 regarding the term “offset hoisting apparatus.” (*See id.*) Specifically, Mr. Schuyleman
14 contends that Mr. Perkin improperly opines that a POSITA would be unable to identify
15 the extent of the “offset hoisting apparatus” in the ’244 Patent, but simultaneously
16 identifies the “offset hoisting apparatus” in diagrams of prior art in other parts of his
17 report. (*Id.* at 10-11; Perkin Reply at 4-6.) Barnhart responds that Mr. Perkin can
18 advance these alternative theories simultaneously. (*See* Perkin Rep. at 12.) As explained
19 more fully below, the court declines to exclude Mr. Perkin’s testimony on this basis.

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21

²⁸ Mr. Schuyleman does not appear to challenge Mr. Perkin’s obviousness conclusions
22 with respect to the Wheeler reference. (*See generally* Perkin Mot.; Perkin Reply.) Accordingly,
the court does not address that portion of Mr. Perkin’s report here.

1 As set forth in § 112, a patent’s specification must contain “a written description
2 of the invention, and of the manner and process of making and using it, in such full, clear,
3 concise, and exact terms as to enable any person skilled in the art to which it pertains, or
4 with which it is most nearly connected, to make and use the same.” 35 U.S.C. § 112. In
5 his report, Mr. Perkin opines that the term “offset hoisting apparatus” lacks written
6 description and enablement, and therefore renders the Asserted Claims indefinite,
7 because the patent language

8 does not reasonably inform a POSITA whether the “offset hoisting
9 apparatus” comprises one or more of the “front mount” or the “rear mount”,
10 or is a separate component . . . Further, it is my opinion that if the POSITA
11 were to interpret the ‘offset hoisting apparatus’ as comprising one or both of
12 the “front mount” and “rear mount”, the POSITA would not be able to make
13 or use the invention whereby the front and rear mount are “fixed with” the
14 “offset hoisting apparatus” as required by claim 1, because the “offset
15 hoisting apparatus” cannot simultaneously *comprise* the “front mount” and
16 “rear mount”, *and* be a separate component which is “fixed with” the “front
17 mount” and “rear mount”. It is also my opinion that if the POSITA were to
18 interpret the “offset hoisting apparatus” as being separate from one or both
19 of the “front mount” and “rear mount”, the ‘244 Patent does not recite
20 sufficient structures, acts, or functions to make clear the scope and meaning
21 of the term “offset hoisting apparatus”, and by extension claim 1.

15 (Perkin Op. Report ¶ 362 (emphasis in original); *id.* ¶ 372; *see also id.* ¶¶ 350-72

16 (offering opinion regarding the various ways to interpret “offset hoisting apparatus” from
17 the claim language).) Mr. Schuyleman posits that Mr. Perkin’s testimony is inconsistent
18 and therefore improper. (*See* Perkin Mot. at 10.) In support, Mr. Schuyleman points to
19 paragraph 82 of Mr. Perkin’s opening report, which provides that “[f]or the purpose of
20 analyzing the term with respect to the prior art, the term ‘offset hoisting apparatus’
21 constitutes an umbrella term for a suspended lifting device designed to lift a load which is
22

1 not positioned directly under the suspension point.” (Perkin Mot. at 10 (citing Perkin Op.
 2 Report ¶ 82).) Mr. Schuyleman also points to Mr. Perkin’s deposition testimony stating
 3 that an “offset hoisting apparatus” is “a system of components that appear to be
 4 unbalanced or offset so that you can accomplish some means of inserting a load into an
 5 opening in a building.” (*Id.* at 10 (citing Perkin Dep. 55:23-54:2); *see also id.* (citing
 6 Perkin Dep. 59:10-25 (stating that an offset hoisting apparatus is the same as an offset
 7 lifting device))).) Mr. Schuyleman asserts that Mr. Perkin can therefore “identify, define
 8 and describe an ‘offset hoisting apparatus’ in every circumstance but for that required to
 9 enable and find support in the written description for the claims of the ’244 Patent.” (*Id.*
 10 at 11.)

11 In response, Barnhart argues that Mr. Perkin can compare the claims of the ’244
 12 Patent to prior art even if he simultaneously argues that those terms are indefinite.
 13 (Perkin Resp. at 13 (first citing *Cochlear Bone Anchored Sols. AB v. Oticon Med. AB*,
 14 958 F.3d 1348, 1360 (Fed. Cir. 2020) and then citing *ImmunoGen, Inc. v. Vidal*, 653 F.
 15 Supp. 3d 258, 290 (E.D. Va. 2023)); *see also* Perkin Op. Report ¶ 101
 16 (“[N]otwithstanding my opinion, *infra* Section XV, that the term ‘offset hoisting
 17 apparatus’ is indefinite, my opinion, and that of a POSITA, is that Saether²⁹ discloses an
 18 improvement to an offset hoisting apparatus”).) Barnhart also argues that Mr. Perkin
 19 supports his conclusion that “offset hoisting apparatus” lacks written description and
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21 ²⁹ “Saether” refers to U.S. Patent No. 3,762,755, which describes, “[a]n apparatus for use
 22 in hoisting heavy loads onto floors within an erected frame of a building.” (*See* Perkin Op.
 Report ¶¶ 98-99.)

1 enablement by “identif[ying] multiple variations” of that term in the prior art. (*Id.*) In
2 reply, Mr. Schuyleman asserts that the case law cited by Barnhart is inapposite because it
3 involves appeals from the PTAB, which “cannot institute *inter partes* review for claims
4 for indefiniteness.” (Perkin Reply at 3-4 (quoting *Samsung Elecs. Am., Inc. v. Prisia*
5 *Eng’g Corp.*, 948 F.3d 1342, 1350 (Fed. Cir. 2020)).) Mr. Schuyleman does not explain,
6 however, why the holding of *Samsung* bars Mr. Perkin from advancing his written
7 description, enablement, and prior art arguments together. Indeed, Mr. Schuyleman has
8 not provided—and the court is not aware of—any case law excluding expert testimony on
9 this basis. Accordingly, the court denies Mr. Schuyleman’s motion to exclude this
10 portion of Mr. Perkin’s testimony.

11 *b. “Therethrough”*

12 Mr. Schuyleman also argues that Mr. Perkin’s opinions that the term
13 “therethrough” lacks written description and enablement should be excluded. (Perkin
14 Mot. at 11.) Mr. Schuyleman refers to paragraph 373 of Mr. Perkin’s opening report:

15 I understand that the Claim Construction Order defined the term
16 “therethrough” as “allowing the rigid boom to slide through one side and out
17 the other of both the front and rear mounts”. In my opinion, the specification
18 of the ‘244 Patent does not contain a sufficient written description of the
19 invention whereby the claimed “rigid boom” can “slide through one side and
20 out the other of both the front and rear mounts” such that a POSITA would
21 be able to make and use the invention as set forth in claim 1. In my opinion,
22 the POSITA would be unclear as to whether the Court’s definition allows for
the boom to enter and completely exit each of the front mount and the rear
mount (by way of the front boom aperture and the rear boom aperture). To
the extent that it does, then in my opinion as a POSITA, this construction is
not supported by the specification.

(Perkin Op. Report ¶ 373.) Mr. Schuyleman asserts that Mr. Perkin’s opinion is “predicated on a ridiculous, contingent interpretation” of the court’s claim construction order, which construed “therethrough” as “allowing the rigid boom to slide through one side and out the other of both the front and rear mounts.” (Perkin Mot. at 11; CC Order at 11.) Barnhart contends that Mr. Perkin’s opinion should not be excluded on this basis. (Perkin Resp. at 10.) The court agrees with Barnhart. Experts are not permitted to disregard or misapply the court’s claim constructions. *See Andersen*, 474 F.3d at 1371 n.2; *Dynetix*, 2013 WL 4537838, at *4. But Mr. Schuyleman has not pointed to any specific testimony in Mr. Perkin’s report indicating that he has ignored or deviated from the court’s construction. Indeed, the court noted in its claim construction order that “[t]he ’244 Patent does not contemplate slidable movement merely ‘inside of’ the front and rear mounts.” (CC Order at 11.) Mr. Schuyleman’s challenge appears to center on Mr. Perkin’s application of the court’s construction to the Accused Products. *See Genband US LLC v. Metaswitch Networks Corp.*, No. 2:14-CV-33-JRG-RSP, 2016 WL 122967, at *3 (E.D. Tex. Jan. 9, 2016) (citing *Spectrum Pharms., Inc. v. Sandoz Inc.*, 802 F.3d 1326, 1337 (Fed. Cir. 2015)). The court accordingly declines to exclude this portion of Mr. Perkin’s testimony.

5. Indefiniteness

Mr. Schuyleman argues that Mr. Perkin provides “conclusory testimony that seven terms are indefinite.” (Perkin Mot. at 12 (citing Perkin Op. Report ¶¶ 375-83); *see also* Perkin Reply at 7 (arguing that “the only testimony that Mr. Perkin provides to support his indefiniteness claims is *ipse dixit*.”).) Mr. Schuyleman offers no analysis to support

1 his argument. (*See generally* Perkin Mot.; Perkin Reply.) Barnhart responds that Mr.
2 Perkin provides the basis for his indefiniteness opinions in the portions of his testimony
3 cited by Mr. Schuyleman. (*See* Perkin Resp. at 15.) The court has reviewed paragraphs
4 375 to 383 of Mr. Perkin's opening report and agrees with Barnhart. The court therefore
5 will not exclude this portion of Mr. Perkin's testimony.

6 IV. CONCLUSION

7 For the foregoing reasons, the court orders as follows:


8 (1) Barnhart's motion to exclude Dr. Klopp's report and testimony is DENIED
9 (Dkt. # 92);

10 (2) Barnhart's motion to strike portions of Dr. Klopp's report is GRANTED in
11 part and DENIED in part (Dkt. # 86);

12 (3) Barnhart's motion to exclude Mr. Morman's testimony is GRANTED
13 (Dkt. # 91); and

14 (4) Mr. Schuyleman's motion to exclude Mr. Perkin's testimony is GRANTED in
15 part and DENIED in part (Dkt. # 93).

16 Dated this 15th day of May, 2025.

17 

18 JAMES L. ROBART
19 United States District Judge
20
21
22